ESTTA Tracking number: **ESTTA741641**

Filing date: **04/21/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91207333
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Date	04/21/2016
Attachments	[060] 2016-04-21 - IPAD LLC Opposition to RxD's Motion to Amend w Hill Decl and Exhs - PUBLIC.pdf(5334317 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RXD MEDIA, LLC,	:	
	:	
Opposer,	:	
	:	
v.	:	**Opposition Nos. 91207333**
	:	**91207598**
IP APPLICATION DEVELOPMENT LLC,	:	
	:	
Applicant.	:	
	:	
	:	

APPLICANT IP APPLICATION DEVELOPMENT LLC'S RESPONSE IN OPPOSITION TO RXD MEDIA, LLC'S MOTION FOR LEAVE TO AMEND ITS NOTICE OF OPPOSITION

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Pursuant to TBMP § 507 and Federal Rule of Civil Procedure 15, Applicant IP Application Development LLC ("IPAD LLC") respectfully submits this Memorandum of Law in Opposition to Opposer RxD Media, LLC's ("RxD") Motion for Leave to Amend Notice of Opposition (the "Motion").

PRELIMINARY STATEMENT

In an effort to forestall an adverse decision on IPAD LLC's pending case-dispositive motion, RxD belatedly seeks to inject three new claims into these proceedings. The Board should not indulge such gamesmanship, however, because RxD's purported new claims are too late and legally insufficient, and allowing them would not only significantly prejudice IPAD LLC, but also would reward RxD's dilatory tactics and signal to others that they may delay Board proceedings with impunity.

First, the Motion is untimely by any measure. It comes ***three-and-half years*** after RxD initiated these proceedings, after ***more than three years*** of discovery, ***more than a year*** after the expert disclosure deadline, ***months if not years*** after receiving the "new facts" that RxD claims to have recently discovered, ***months*** after discovery ended, and a ***month*** after IPAD LLC filed its motion for summary judgment and the deadline for such motions.

Second, even if the Motion were timely, RxD's three new claims are futile: (1) its proposed claim that IPAD LLC lacked a bona fide intent to use the IPAD mark is contradicted by RxD's own proposed pleadings and the record; (2) its proposed claim that IPAD LLC's marks are not distinctive is procedurally improper, and wrong on the facts; and (3) its proposed "unfair competition" claim is nonsensical because the Board has no jurisdiction to hear such claims, and in any event, it would necessarily fail after the Board decides the issues in IPAD LLC's pending summary judgment motion.

Third, RxD's belated, futile claims are prejudicial to IPAD LLC because they would fundamentally change the nature of these proceedings. From its inception in 2010, this case has turned on whether RxD can prove that it has protectable trademark rights that predate IPAD LLC's priority date. Now, on the eve of the first trial period, and with IPAD LLC's dispositive motion pending, RxD's new claims would require a sea change in terms of the scope and focus of these proceedings. If RxD's procedural maneuverings were allowed, then IPAD LLC would be faced with the choice of either

foregoing the evidence necessary to defend against the newly added claims or incurring the costs and delay attendant to reopening discovery and engaging in a new round of briefing. To place IPAD LLC this untenable position would clearly be prejudicial.

Finally, the Motion is nothing more than a belated, last-ditch effort to prevent the Board from finally disposing of RxD's meritless oppositions. Given RxD's prejudicial and inexcusable delay in bringing its futile claims, it is abundantly clear that RxD filed its Motion in bad faith. If the Board were to reward RxD's dilatory conduct, then it would set a dangerous precedent that would no doubt encourage others to pursue the same dilatory practices, which would inevitably hamstring the Board's ability to resolve matters in its docket expeditiously, to the disadvantage of the Board and litigants in Board proceedings.

For all of these reasons, the Motion should be denied in its entirety.

FACTS[1]

A. RxD's Website

In October 2006, RxD registered the ipad.mobi domain, and launched a website in September 2007, which, by its own admission, served as an "online mobile notepad" for users to jot notes and store lists online. (D.E. 52 at 2–6.) Since then, RxD has spent meager amounts on advertising, earned ***less than*** [redacted] in total revenue ***to date***, and garnered negligible attention in the marketplace.[2] (*See id.* at 4–6.)

B. Apple's Goods & Services

After years of widespread speculation that Apple would release a tablet computer called the "IPAD," [redacted] selected the name "IPAD" to be consistent with its famous family of "i"-formative marks (*e.g.*, iPod, iPhone, iTunes), which are associated with Apple in the minds of consumers. (D.E. 52 at 6.) RxD's founder, Brian Clements, was aware of the speculation that Apple would release an "IPAD" product; for example, on January 9, 2007—

[1] Unless otherwise noted, the facts identified herein are discussed more fully in the IPAD LLC's Motion for Summary Judgment (D.E. 52), to which IPAD LLC respectfully directs the Board for citations.

[2] Of course, the relevant date for purposes of priority is 2009, when IPAD LLC filed its first application.

before launching the ipad.mobi site—he posted in an online forum in a thread entitled "Apple's new iPhone" and said, "I just hope someone comes out with the iPad." (*Id.*) On January 27, 2010, Apple announced the launch of its new "iPad" tablet device, which would be available for purchase in late March 2010. (*Id.* at 8.)

At the time Apple launched the iPad device, it was unaware of RxD or ipad.mobi because (1) RxD had not yet filed any trademark applications, and thus was not in any trademark database; and (2) [redacted] (*Id.*) RxD asserts, wrongly, that [redacted] (Mot. at 6), but that is belied by the record including, *inter alia*, RxD's own exhibits for the Motion. (D.E. 55, Sakagami Decl., Ex. X.) RxD also deceivingly asserts, with no evidentiary support, [redacted] (Mot. at 7), when in reality, as RxD well knows, [redacted], which makes sense. (Hill Decl., filed concurrently herewith, Ex. 1 ("La Perle Dep.") 106:9–22; Hill Decl. ¶ 4.)

C. IPAD LLC's Applications

Consistent with [redacted].[3] (D.E. 52 at 7 n.9; La Perle Dep. 33:19–34:14.) On January 16, 2010, IPAD LLC filed intent-to-use ("ITU") Application No. 77/913,563 (the "'563 Application") for the IPAD mark in connection with various services in International Classes 38 and 42, with a priority date of July 16, 2009 based on a foreign application. ('563 Application at 1.) On February 3, 2010, IPAD LLC filed ITU Application No. 77/927,446 (the "'446 Application") for IPAD in connection with various services in International

[3] [redacted] (D.E. 52 at 2 n.2.)

Classes 35, 39, and 42, with a priority date of January 25, 2010 based on a foreign application. ('446 Application at 1.)

In prosecuting its applications (collectively, "IPAD LLC's Applications"), and in response to PTO office actions, IPAD LLC submitted voluminous evidence showing acquired distinctiveness. (D.E. 52 at 9; '446 Application, D.E. 11 (Oct. 25, 2010), 17 (July 14, 2011); '563 Application D.E. 12 (Oct. 25, 2010), 18 (July 4, 2011).) It ultimately submitted a motion for reconsideration after final refusal that attached evidence showing that "the IPAD mark had clearly acquired distinctiveness with respect to the services covered by" IPAD LLC's Applications, including "a class-by-class analysis showing how the services covered by [the applications] were closely and directly related to the features and functionality of Applicant's licensee and [parent's] . . . iPad device," and showing the fame of (1) the IPAD mark as applied to goods and (2) Apple's "i"-family of marks. ('446 Application, D.E. 26 (Feb. 21, 2012) at 2; '563 Application, D.E. 36 (Apr. 18, 2012) at 2.) In response to IPAD LLC's motion for reconsideration, the PTO approved IPAD LLC's Applications pursuant to § 2(f). ('446 Application, Publ'n & Issue Rev. Complete (Mar. 7, 2012); '563 Application, Publ'n & Issue Rev. Complete (May 23, 2012).)

D. RxD's Application & Opposition

On March 12, 2010, after Apple announced and began selling the iPad device, RxD finally applied to register IPAD for use in connection with "providing temporary use of web-based software application for mobile-access database management whereby users can store and access their personal information" in International Class 42 (Application No. 77/958,000 ("RxD's Application")), claiming a first-use date of September 1, 2007. (D.E. 52 at 15.) On June 22, 2010, the PTO suspended its *ex parte* review of RxD's Application pending disposition of IPAD LLC's '563 Application. (*Id.* at 9 n.12.) On January 21, 2016, the PTO withdrew RxD's Application from suspension and issued a non-final refusal because RxD's use of the term "ipad" was descriptive. (*Id.* at 9–10.)

RxD filed these consolidated oppositions on October 5, 2012 (collectively, the "Proceedings"). (D.E. 1, 12.) Section 2(d) is RxD's sole ground for opposition, claiming RxD's priority and a likelihood

of confusion. (D.E. 1.) IPAD LLC answered on October 8, 2012, asserting, *inter alia*, that RxD's use was "descriptive of [its] 'Internet Notepad' . . . and has not acquired distinctiveness." (D.E. 4 at 3.)

E. Discovery

Discovery began on December 15, 2012, and ended more than three years later on January 6, 2016 (D.E. 2 at 2; D.E. 49 at 3), following a number of extension requests by both parties (D.E. 8, 11, 16, 18, 23, 33, 40, 50). The expert disclosure period ended on January 10, 2015, without either party seeking or providing expert discovery. (D.E. 30.) During more than three years of fact discovery, the parties exchanged documents and written discovery and produced witnesses for depositions. (*See* Hill Decl. ¶¶ 2–14.) Throughout discovery, IPAD LLC objected to RxD's requests on various grounds, including [redacted]. (*See, e.g.*, D.E. 55, Sakagami Decl., Ex. C at 4–5.)

Notwithstanding its various objections, IPAD LLC produced, among other things, more than 3,000 pages of website screen captures on October 30, 2015, which show use of IPAD in connection with various applied-for services.[4] (Hill Decl. ¶ 3.) Examples are set forth below:[5]

Applied-For Service	Evidence
"[A]dvertising and marketing services, namely promoting the goods and services of others"	IPADLLC_002225–29 ("Everything changes with iPad. . . . We put together some of our favorite apps and ideas to help you get started.")
	IPADLLC_001973–74 (promoting curated set of software applications designed "[e]specially for iPad")

[4] In addition to the documents that IPAD LLC produced, between March 21, 2013 and November 2, 2015, IPAD LLC served written discovery responses providing further information about the services for which its marks are used. (Mot. at 2; D.E. 55, Sakagami Decl. ¶¶ 4–5, 7, 9–10, 12; Hill Decl. ¶¶ 6–10.) Among those is IPAD LLC's Amended Response to Interrogatory No. 11 (seeking identification of every service for which IPAD LLC has used or is using the IPAD mark), which IPAD LLC served on November 1, 2013. (D.E. 55, Sakagami Decl., Ex. C at 6.) Subject to various objections, including relevance, IPAD LLC stated that, [redacted] (*Id.* at 5.) [redacted]. (*Id.*)

[5] The excerpts identified in the below table are attached hereto as Exhibit 2 to the Hill Declaration.

	IPADLLC_001490–92 (curated list of software applications and materials used in connection with "iPad in Education")
	IPADLLC_002902–33 (promoting business software applications in connection with "iPad in Business")
	IPADLLC_001504–10 (promoting IBM and Cisco software for use in connection with "iPad in Business")
"[D]esign and development of computer hardware and software" and "support and consultation services for developing computer systems, databases and software applications"	IPADLLC_004033 (iPad app developer suite, including "Resources," "Program," "Support,", and a "Member Center")
	IPADLLC_001973–74 (curated set of software applications designed "[e]specially for iPad")
"[T]ransmission of data" and "provision of telecommunication access to web-sites featuring multimedia materials"	IPADLLC_001968–69 (identifying "partners" such as AT&T, Sprint, and T-Mobile that provide iPad Air 2 cellular connectivity)
"[P]roduct demonstrations provided instore and via global communications networks and other electronic and communications networks"	IPADLLC_001521–29 (offering "Workshops" and "Youth Programs" called "iPhone & iPad Basics" and "Personalize Your iPhone & iPad")
	IPADLLC_004019 (offering "[w]orkshops and classes" including one-on-one training and children's camps in connection with "iPad")
"[R]etail store services in the field of books, magazines, periodicals, newsletters, journals and other publications on a wide range of topics of general interest"	IPADLLC_001490–92 (curated list of "Apps, books, and more" used in connection with "iPad in Education")
"[P]rovision of telecommunications connections to electronic communication networks, for transmission or reception of audio, video or multimedia content; providing telecommunication access to digital music web sites on the Internet"	IPADLLC_002665 (promoting iPad in connection with streaming multimedia services in connection with Apple TV and AirPlay for "iPad in Education")
"[P]roviding business and commercial information over computer networks and global communication networks"	IPADLLC_004097 (providing online "Communities" called "Using iPad" and "iPad in Business and Education")

On March 20, 2015, RxD moved to compel certain discovery from IPAD LLC. (D.E. 34.)[6] In its decision on the motion, the Board admonished RxD that it could only obtain certain non-party documents by subpoenaing Apple (D.E. 47 at 11) and narrowed the scope of most of RxD's discovery requests. (D.E. 47; D.E. 55, Sakagami Decl., Ex. I.) After RxD issued subpoenas to Apple, Apple timely served

[6] RxD identifies only one of the discovery requests that were subject to its motion to compel as relevant to the present Motion—Document Request No. 39 (seeking correspondence with Steve Jobs).

objections (in early November 2015), and RxD never sought to meet and confer about those objections. (D.E. 55, Sakagami Decl., Ex. J; Hill Decl. ¶ 11.)[7]

On December 10, 2015, RxD deposed Thomas La Perle, Director of the Trademark & Copyright Group at Apple and Manager of IPAD LLC, as a Rule 30(b)(6) witness for Apple and IPAD LLC. (D.E. 41, La Perle Decl. ¶ 1; Hill Decl. ¶ 2.) Pursuant to a court order, RxD deposed Douglas Vetter on behalf of Apple on February 10, 2016, one month after discovery closed on January 6, 2016. (D.E. 49–50; Hill Decl. ¶¶ 12–13.)[8] Apple and IPAD LLC each made final document productions on that date, other than a few documents not relevant here. (Hill Decl. ¶¶ 13–14.)

F. Post-Discovery Developments in the Proceedings

On March 7, 2016—the deadline for summary judgment motions—IPAD LLC filed its motion for summary judgment because, as a matter of law: (1) RxD's use is descriptive based on, *inter alia*, its own admissions; (2) RxD's paltry evidence cannot show distinctiveness at any time; and thus, (3) RxD cannot show priority. (*See generally* D.E. 52.) RxD filed its opposition on April 6, 2016. (D.E. 55.)

A month later, and concurrently with its summary judgment opposition, RxD filed its motion seeking for the very first time to amend its Notices of Opposition. (D.E. 57.) Specifically, RxD seeks leave to add three new claims, that: (1) IPAD LLC lacked a bona fide intent to use the IPAD mark in

[7] In its objections to the deposition subpoena, Apple objected to Topic No. 2—which is the only deposition topic that RxD identifies as relevant to its proposed new claims—[redacted] (*See* Hill Decl., Ex. 3 at 7–9.) [redacted] (*See* D.E. 55, Sakagami Decl., Ex. J, at 18–21, 26–27, 29–30, 33.) [redacted] (*Id.* at 12.)

[8] RxD had served a subpoena to take Mr. Vetter's deposition prior to the close of discovery, which Apple moved to quash in the Northern District of California, and the parties agreed that Mr. Vetter's deposition could proceed after the close of discovery if necessary. (D.E. 49 ¶ 6.) The Northern District of California granted in part and denied in part Apple's motion to quash, limiting Mr. Vetter's deposition to two hours. (Hill Decl., Ex. 4.)

connection with the applied-for services; (2) the applied-for marks had not achieved secondary meaning; and (3) IPAD LLC's conduct constitutes "unfair competition." (D.E. 57 at 1.)

ARGUMENT

I. THE BOARD SHOULD DENY LEAVE TO AMEND BECAUSE RxD's PROPOSED CLAIMS ARE UNTIMELY, FUTILE, PREJUDICIAL, AND MADE IN BAD FAITH

Under Federal Rule of Civil Procedure 15(a), which governs whether leave to amend may be granted after responsive pleadings have been filed, TBMP § 507.01, the Board may consider factors including "undue delay, bad faith or dilatory motive on the part of the movant, . . . undue prejudice to the opposing party by virtue of allowance of the amendment, [and] futility of the amendment." *See Foman v. Davis*, 371 U.S. 178, 182 (1962); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 U.S.P.Q.2d 1540, 2001 WL 1869327, at *2–3 (T.T.A.B. Dec. 19, 2001). Here, RxD's Motion should be denied in its entirety because it is untimely, legally futile, would impose significant prejudice, and is a dilatory ploy to avoid judgment.

A. RxD'S Motion Should Be Denied Because It Is Untimely

Apart from any other defects in the Motion, RxD's excessive delay in bringing it, standing alone, warrants denial. *See Trek Bicycle*, 2001 WL 1869327, at *2–3 (finding no prejudice, but denying for undue delay); *Kajita v. Walter Kidde & Co.*, 185 U.S.P.Q. 436, 1975 WL 20793, at *2 (T.T.A.B. Apr. 3, 1975) (denying motion, estopping petitioner's proposed descriptiveness claim because "it is mandatory that a party assert all claims" in its opening pleadings, and no "intervening facts" arose during three-year pendency). RxD has had years to bring these claims, yet it waited until three months after the close of discovery, and a month after IPAD LLC filed its summary judgment motion in accordance with the deadline set by TBMP § 528.02. The Board routinely finds similar delay warrants denying leave to amend. *See Media Online Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q.2d 1285, 2008 WL 4419361, at *2 (T.T.A.B. Sept. 29, 2008) (motion "should be filed as soon as any ground . . . becomes apparent" and "long" "unexplained delay" warrants denial); *Int'l Fin. Corp. v. Bravo Co.*, 64 U.S.P.Q.2d 1597, 2002 WL 1258278, at *7–8 (T.T.A.B. June 5, 2002) (denying where "opposer waited over two years, and only in response to applicant's motion for summary judgment" after close of discovery); *Together Networks*

Holdings v. Fellow Fish, 2015 WL 9906649, at *2 (T.T.A.B. Sept. 9, 2015) (non-precedential) (denying where filed six weeks after close of discovery and descriptiveness claim could have been brought earlier).

RxD has the burden of explaining its delay, which it has wholly failed to do. *See Kellogg Co. v. Shakespeare Co.*, 2005 WL 1581551, at *2 (T.T.A.B. June 30, 2005) (non-precedential). RxD was required to file its motion as soon as any ground "bec[ame] apparent," rather than waiting for evidence that is, at best, cumulative of what it knew months if not years prior. *See*, *e.g.*, *Media Online*, 2008 WL 4419361, at *2; *see also Trek Bicycle*, 2001 WL 1869327, at *2 (denying where filed before discovery closed because it was based on facts known before opposing); *Kajita*, 1975 WL 20793, at *2. That is precisely what RxD did, however. Regardless of what RxD claims to have learned, it waited months, if not years, after learning it. Specifically, RxD claims "Applicant and Apple's discovery responses and the deposition testimony of Mr. LaPerle [sic] and Mr. Vetter" are "the basis of the additional claims." (Mot. at 7.) But RxD delayed between five months and over two years from the service of those discovery responses, which ranged from March 21, 2013 and November 6, 2015, before raising its new claims. (*See supra* Facts at 5 n.4.) It delayed four months after taking Mr. La Perle's deposition on December 10, 2015. (*Id.* at 7.) It delayed two months after taking Mr. Vetter's deposition on February 10th. Further, RxD fails to identify any information that came to light in any of these depositions or discovery responses that differed from what was available to it long before.

Using Mr. Vetter's deposition date, as RxD now urges, still renders the Motion untimely because, at the very least, RxD admits to receiving relevant discovery responses and testimony long before then. *See Black & Decker Corp. v. Emerson Elec. Co.*, 84 U.S.P.Q.2d 1482, 2007 WL 894416, at *3 (T.T.A.B. Mar. 23, 2007) (rejecting argument that opposer could not have known of potential lack of bona fide intent claim until cross-examining applicant's witness because it already received interrogatory responses which "should have led it to file a motion to amend" or conduct more targeted discovery). In *Virgin Enterprises Ltd. v. Casey*, 2012 WL 12517279 (T.T.A.B. May 29, 2012), the Board found a far shorter delay of 29 days from receipt of relevant discovery responses sufficient to deny leave to amend. *Id.* at *2. ("There appears to be no reason why opposer could not have immediately reviewed [the] written

responses upon receipt" and "promptly filed a motion . . . on the basis of such responses.")[9] In the face of such delay, the Board routinely denies leave to amend.[10]

RxD's claims are even more untimely when considering the substance of the so-called "new evidence," which consists entirely of information that was publicly available when RxD initiated these Proceedings and throughout their pendency, for example, on Apple's website, in its *ex parte* application files,[11] and in served discovery. (*See supra* Facts at 3–4, 5–7.) As to the bona fide intent and distinctiveness claims, RxD alleges only the insufficiency of evidence at the close of discovery showing actual or planned use for the applied-for services, but RxD's cited evidence undermines its argument. (Mot. at 9–10.) ***First***, RxD selectively quotes from an interrogatory response [redacted] but IPAD LLC served that response ***two-and-a-half years*** before RxD filed its Motion on April 6, 2016 (*see* Mot. at 10; D.E. 55, Sakagami Decl., Ex. C at 5), and therefore the claim is untimely. ***Second***, the interrogatory response cited [redacted] that RxD easily could have accessed in November 2013 (or before) to assess the claimed

[9] RxD argues that the Motion is timely because it was filed two months after the last deposition in the case, citing *Railrunner N.A., Inc. v. N.M. Dep't of Transp.*, 2008 WL 8973295, at *1 (T.T.A.B. July 17, 2008), and *TBC Brands, LLC v. Sullivan*, 2008 WL 1741919 (T.T.A.B. Mar. 31, 2008) (non-precedential). (Mot. at 7–8.) Both of these cases are distinguishable, however, because the applicants in those cases did not even respond to the motion for leave to amend, and impliedly consented to the motion by arguing the merits of the proposed new claims in summary judgment briefing. *Railrunner*, 2008 WL 8973295, at *1 (noting that applicant "did not respond to the motion" and "to the contrary, [its] response to opposer's motion for summary judgment appears to assume that the motion to amend will be granted."); *TBC*, 2008 WL 1741919, at *2 (noting applicant failed to object to the motion to amend, and argued the issue on the merits in its motion for summary judgment).

[10] *See, e.g.*, *Media Online*, 2008 WL 4419361, at *2 (denying motion where petitioner "consulted dictionary definitions and accessed respondent's web site," which "could quite easily have been undertaken prior to filing" or "any prompt investigation conducted immediately thereafter"); *Black & Decker*, 2007 WL 894416, at *3 (denied where party delayed two years after receiving relevant discovery responses); *Trek Bicycle*, 2001 WL 1869327, at *2 (denied when opposer should have known at initiation); *United Homecare Servs., Inc. v. Santos*, 2013 WL 11247709, at *2 (T.T.A.B. July 23, 2013) (non-precedential) (denied when delayed fourteen months after receiving discovery responses).

[11] The entire prosecution history of IPAD LLC's Applications are part of the evidentiary record. *See* TBMP § 528.05(a)(1); 37 C.F.R. § 2.122(b).

uses and brought its motion at that time. *See Media Online*, 2008 WL 4419361, at *2. In fact, RxD now argues, years after the fact, that those same webpages are "new facts" that support its Motion. (Mot. at 2–3, 5, 10.) ***Third***, RxD's argument ignores other uses in the interrogatory response, including [redacted], which are supported by evidence in the prosecution history, and produced in discovery. (*See supra* Facts at 3–4, 5–7.) ***Finally***, RxD ignores the file history of IPAD LLC's Applications, which contains extensive evidence—submitted well before these Proceedings were initiated—showing that the applied-for marks were or would be used with services for closely related and famous goods under the same mark, or part of the same family of marks, which the PTO accepted under § 2(f). (*See supra* Facts at 3–4.) That evidence was available to RxD long ago.

Nor is any of the "evidence" RxD cites for its "unfair competition" new. The alleged basis is IPAD LLC's "recently asserted position in its Motion for Summary Judgment that the opposition should be dismissed because RxD has no cognizable service mark rights[.]" (Mot. at 8.) But RxD knew of this position since the start of these Proceedings when IPAD LLC asserted it in its Answer as its First Affirmative Defense that RxD had no prior rights because its "use of IPAD is merely descriptive of Opposer's 'Internet Notepad' . . . and has not acquired distinctiveness." (D.E. 4 at 3.)[12]

B. RxD'S Proposed Amendments Also Fail Because They Are Futile

The Motion also should be denied as futile because the amendments are "legally insufficient, or would serve no useful purpose[.]" TBMP § 507.02; *Trek Bicycle*, 2001 WL 1869327, at *3.

1. The Record Shows IPAD LLC Had a Bona Fide Intent to Use Its Mark

RxD's proposed amendment is futile because the proposed allegations confirm what the record shows—namely, that IPAD LLC had sufficient bona fide intent to support IPAD LLC's Applications. *See, e.g.*, *Lane Ltd. v. Jackson Int'l Trading Co.*, 33 U.S.P.Q.2d 1351, 1994 WL 740491, at *6–7

[12] RxD's other citations are similarly insufficient to justify its delay because they are facts it has long known: (1) IPAD LLC's Applications, which were filed in 2010; (2) the fact that allowing IPAD LLC's Applications to register would create presumptive exclusive rights in the mark, which RxD knew at least as early as when it filed its own application to register seeking the same benefit; and (3) RxD's own testimony about its use and instances of actual confusion that allegedly occurred in 2010, and 2013 or 2014 . (Mot at 8, 10–11.) Thus, RxD cites no "new evidence" justifying amendment of its pleadings.

(T.T.A.B. Oct. 21, 1994) (bona fide intent may be shown by "formulation and implementation of its business plan and a licensing program," correspondence with potential licensees, or "evidence regarding its predecessor's activities and experience in licensing its prior mark").[13]

The record and RxD's own allegations confirm that IPAD LLC had a bona fide intent to license its marks for services, and in fact [redacted] (*See, e.g.*, Mot. App'x 1 ¶¶ 4, 6 (alleging IPAD LLC filed a verified statement of a bona fide intent to use the marks pursuant to § 1(b)); *id.* ¶ 8 ([redacted]); *id.* ¶ 31 (alleging IPAD LLC, [redacted] offers related goods under the same mark). The record is equally clear that Apple has used the IPAD mark for services claimed in IPAD LLC's Applications. (*See supra*, Facts at 3–4, 5–7). Such use [redacted] inures to IPAD LLC's benefit and supports the existence of bona fide intent to use the mark through licensing. *Lane*, 1994 WL 740491, at *6–7; *see also Medbox, LLC v. PVM Int'l, Inc.*, 2013 WL 5820846, at *6–7 (T.T.A.B. Oct. 10, 2013) (non-precedential) (holding that intent to license and use by related company suffices); *Signature Brands, Inc. v. Robert Lehrer Assocs.*, 1999 WL 149832, at *5 (T.T.A.B. Mar. 9, 1999) (non-precedential).[14]

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[13] RxD's sole authority, *Research in Motion Ltd. v. NBOR Corp.*, 92 U.S.P.Q.2d 1926, 2009 WL 4694941 (T.T.A.B. Dec. 2, 2009) (cited Mot. at 9), is not to the contrary. There, the Board found that the factual record was "devoid" of any evidence that the applicant intended, or was even capable of, offering the applied-for goods, or had made any efforts toward doing so. *Id.* at *4–6. In fact, the applicant failed to even offer testimony about its intent, and admitted that "it has not offered any goods or services for sale under the involved mark" and "the mark has not been used and no plans have been made as to how the mark may be used[.]" *Id.* at *4–5. That clearly is not the case here, where IPAD LLC has produced thousands of pages of evidence, including screen captures, documenting its use. (*See supra* Facts at 5–7.)

[14] RxD claims, wrongly, that the identified uses of the IPAD mark for services are "peripheral use[s] . . . specifically intended to promote the goods" under the IPAD mark, rather than service mark uses (Mot. at 10), but its reliance on *In re Dr Pepper Co.*, 836 F.2d 508 (Fed. Cir. 1987), in support of that assertion is misplaced. The alleged services in *Dr. Pepper* consisted of promotional contests for related goods, and thus were merely routine promotional activities incidental to promoting sales of the product (Dr. Pepper-branded soda) rather than separate services. *Id.* at 510. Here, in contrast, the applied-for services are not merely promotional advertising for iPad devices but rather a variety of related but distinct services offered in connection with the goods, including retail services, developer support, data plan services, and business and educational uses. (*See supra* Facts at 5–7 & n.4.) As such, they go well beyond the "routine or ordinary" activities "necessarily done" for the iPad device. *See Dr. Pepper*, 836 F.2d at 511.

2. RxD's Proposed Lack of Distinctiveness Claim Is Premature and Unsupported by Any Evidence

RxD's proposed claim that IPAD LLC's applied-for mark lacks distinctiveness is premature because, as RxD acknowledges in its proposed pleading, IPAD LLC has not yet filed statements of use with respect to its applications. (Mot., App'x 1 ¶ 31.) *See* TMEP § 1212.09(a) ("A claim of distinctiveness under § 2(f) is normally not filed in a § 1(b) application before the applicant files an allegation of use, because a claim of acquired distinctiveness, by definition, requires prior use."); *see also Eastman Kodak Co. v. Bell & Howell Doc. Mgmt. Prods. Co.*, 23 U.S.P.Q.2d 1878, 1992 WL 224556, at *2 (T.T.A.B. June 8, 1992) (because "the question of descriptiveness cannot be resolved until use has begun," an opposition must be dismissed where no statement of use has yet been filed); *Six Continents Hotels, Inc. v. Marriott Int'l Inc.*, 2004 WL 2075110 (T.T.A.B. Aug. 31, 2004) (non-precedential) (where statement of use has not yet been filed for ITU application, "any challenge to applicant's mark on the ground that it does not function as a service mark at this time would likely be premature").

In any event, even if RxD's claim were not premature, IPAD LLC already has shown acquired distinctiveness by virtue of transference from closely related products sold under (1) its famous IPAD mark for goods and (2) Apple's famous family of "i"-formative marks. (*See supra* Facts at 4.) *See also Kellogg Co. v. Gen. Mills, Inc.*, 82 U.S.P.Q. 2d 1766, 2007 WL 499921, at *5–8 (T.T.A.B. Feb. 15, 2007) (holding that applicant need not "submit extrinsic evidence" to show relatedness or transference, but can rely on "close relationship" that is "self-evident from the respective identifications"). IPAD LLC submitted voluminous evidence showing both relatedness and transference, which the PTO accepted. (*See supra* Facts at 4.)

Nor has RxD met its burden of rebutting IPAD LLC's evidence of acquired distinctiveness. *Gen. Mills*, 2007 WL 499921, at *6 (finding that opposer failed to rebut the *prima facie* showing of acquired distinctiveness and transference to related goods). RxD's proposed allegations amount only to a charge of present non-use in connection with the applied-for services, which is irrelevant to a claim that a mark has acquired distinctiveness by virtue of transference from related goods. *See, e.g.*, *In re Dial-A-Mattress Op.*

Corp., 240 F.3d 1341, 1347 (Fed. Cir. 2001) (an ITU applicant can show acquired distinctiveness where the "same mark acquired distinctiveness for related goods or services" and such distinctiveness "will transfer" to the applied-for services "***when the mark is used***" (emphasis added)).

3. "Unfair Competition" Is Not a Cognizable Claim

RxD's "unfair competition" claim is nonsensical because that is not a ground for opposition in proceedings before the Board. Even if RxD's unambiguous allegations are construed as a cognizable claim, they would fail along with RxD's pending § 2(d) claim because RxD has no protectable rights.

First, the Board has no jurisdiction to hear such a claim. *Seculus Da Amazonia v. Toyota Jidosha Kabushiki Kaisha*, 66 U.S.P.Q.2d 1154, 2003 WL 648117, at *4 n.5 (T.T.A.B. 2003) ("[I]t is well-settled that the Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition."); *see also* J. Thomas McCarthy, *Trademarks & Unfair Competition* § 20:21:50 ("The Trademark Board does not have jurisdiction over allegations of unfair competition: such issues are not grounds for an opposition or cancellation proceeding."). Here, the Motion and proposed pleading refers to the cause of action as "unfair competition," and lifts the language from § 43(a). (Mot. at 1; *id.*, App'x 1 at "Count IV: Unfair Competition" & ¶ 44.) The Board, however, "is not the proper forum in which to assert Section 43(a) claims because the Board has no original jurisdiction over such claims." *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 U.S.P.Q. 151, 1983 WL 54113, at *2 (T.T.A.B. 1983), *aff'd*, 739 F.2d 624, 222 U.S.P.Q. 741 (Fed. Cir. 1984).

RxD relies on one federal court case (Mot. at 9, 11 (citing *Belmora LLC v. Bayer Consumer Care AG*, -- F.3d --, 2016 WL 1135518, at *7–8 (4th Cir. Mar. 23, 2016)), but unlike the Board, Article III courts have jurisdiction to hear unfair competition claims. Further, *Belmora* considered only the procedural issue of ***prudential standing***; specifically, the court reviewed whether it was proper to dismiss certain claims for want of Article III standing where plaintiff owns a Mexican trademark for medicine that it does not use it in the United States, but has customers in border areas, and defendant passed off its medicine as that of plaintiff. *Belmora*, 2016 WL 1135518, at *3–12. Neither the standing issue, nor the "passing off" issue is present here. Moreover, "passing off" as alleged in *Belmora* is grounds for both a

Section 43(a) unfair competition claim in federal court and also for cancellation of a registered mark under 15 U.S.C. § 1064(3) for "misrepresentation of source." RxD, however, does not allege that IPAD LLC "passed off" RxD's services as those of IPAD LLC, nor that IPAD LLC "passed off" its own services as RxD's and even if it did, "misrepresentation of source" is only grounds for cancellation, not opposition. *See United Indus. Corp. v. OMS Invs., Inc.*, 2010 WL 4035138, at *3 (T.T.A.B. Sept. 30, 2010).

RxD argues that IPAD LLC was "willfully blind" to RxD's prior rights, and that this "supports" an unfair competition claim. (*See* Mot. at 11.) As discussed above, however, the Board has no jurisdiction to hear unfair competition. Further, RxD cites only *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060 (2011), which is a wholly irrelevant patent litigation involving a statutory claim for vicarious infringement liability via inducement, pursuant to 35 U.S.C. § 271(b). *Id.* at 2068–69. Even if it were relevant here (which it is not), "willful blindness" is not a cause of action, but rather is an alternative theory for charging the defendant with culpable knowledge, and applies when a defendant subjectively believes that there is a high probability that a fact exists, and takes deliberate actions to avoid learning of that fact. *Id.* at 2069–70. Here, RxD alleges that IPAD LLC was "willfully blind" to RxD's prior rights, but only "in the alternative, should this Board conclude that RxD does not have cognizable service mark rights." (Mot. at 8.) Thus, RxD's willful blindness theory only comes into play if the Board has already found that RxD has no prior rights to which IPAD LLC could have been willfully blind. In any event, there is absolutely no evidence of willful blindness.[15]

Setting aside RxD's improper "unfair competition" claims, the allegations, at best, can be construed only as allegations of a likelihood of confusion (*see* Mot. App'x 1 ¶ 44 (in "Unfair Competition

[15] RxD cites no evidence that IPAD LLC believed that there was a high probability that RxD had prior rights. In fact, to the contrary, as argued more fully in IPAD LLC's fully briefed motion for summary judgment, [redacted] (*See generally* D.E. 52 at 4–6; *supra* at 3.) IPAD LLC also did not take deliberate actions to avoid learning of potential third-party rights. [redacted] (Mot. at 7), but in fact [redacted]. (*See supra* Facts at 3.)

Count" alleging that IPAD LLC's use "so resembles Opposer's that Applicant's use is likely to cause confusion")), but that has been RxD's claim all along, and is the subject of IPAD LLC's now fully briefed summary judgment motion. Further, allowing amendment would be the definition of futile because RxD argues "unfair competition" as an alternative if the Board grants IPAD LLC's summary judgment motion (Mot. at 8), *i.e.*, the "alternative" claim only is triggered if the Board has already decided it cannot prevail.

C. The Proposed Amendments Would Be Prejudicial to IPAD LLC Because They Would Inject Futile Claims at an Unconscionably Late Stage, Impose Unwarranted Delay and Expense, and Hamstring IPAD LLC's Defense

RxD's delay and the futility of its amendments show that they would be extremely prejudicial to IPAD LLC, and should be rejected for that reason as well. *See MediaOnline*, 2008 WL 4419361, at *3 (finding prejudice from delay in cross-motion to amend in response to motion for judgment on the pleadings); *see also Rehab. Inst. of Pittsburgh v. Equitable Life Assurance Soc'y of U.S.*, 131 F.R.D. 99, 102 (W.D. Pa. 1990) (noting amendments requiring "significant new preparation," and "added burden of further discovery, preparation, and expense" are prejudicial to the "right to a speedy and inexpensive trial on the merits."). For three-and-a-half years, the crux of these Proceedings has been whether RxD can prove priority. RxD never put any other claims in issue. IPAD LLC properly structured its discovery to be "proportional" to "the needs of the case" as defined by the issues that RxD actually raised. *See* TBMP § 402.01 (parties must "take into account the principles of proportionality" and "may not engage in 'fishing expeditions' and must act reasonably in framing discovery requests"); Fed. R. Civ. P. 26(g)(1)(B)(iii). IPAD LLC consistently objected to RxD's overreaching discovery on various grounds, including [redacted] (*See, e.g.*, *supra* at 5–7; D.E. 55, Sakagami Decl., Ex. C at 4–5.)

RxD never raised the issues of unfair competition or bona fide intent.[16] As for distinctiveness, RxD's lone motion to compel argued, in the abstract, that certain discovery responses were proper

[16] RxD's Motion to Compel discusses "intent" and "bona fides," but only in the context of confusion, secondary meaning, and "unclean hands." (*See* D.E. 34 at 9, 11, 15, 17, 19–20.) Unsurprisingly, given that omission, the Board's Order also never addressed the issue of bona fide intent to use. (D.E. 47.)

because they might lead to discovery about distinctiveness, among other issues, but never indicated that it would pursue that claim at any point. Specifically, RxD sought to compel (1) an answer to an interrogatory seeking identification of marketing agencies, (2) documents about consumer studies; and (3) correspondence with Steve Jobs. (D.E. 47 at 4–5, 7–8.) RxD cites only one of these as relevant to the present Motion,[17] however, and RxD never sought to compel further discovery after the Board's order.

Further, after the Board admonished RxD that it must seek certain information from non-party Apple by subpoena, RxD issued subpoenas to Apple, to which Apple timely responded, subject to various objections, including that the discovery was irrelevant to any claim, beyond the scope of the Board proceedings, and improper because the applications are ITUs. (*See supra* Facts at 5–7 & n.7.) RxD never sought to meet and confer about any of Apple's responses, or to provide *any* further basis for the relevance of its request. In one response, [redacted] (*Id.* at 12.) Thus, RxD knew the state of IPAD LLC's and Apple's evidence with regard to such evidence of use no later than November 2015, but RxD never suggested that such evidence was lacking for any purpose or offered any additional basis to support the relevancy of those requests, including for the purposes of adding a descriptiveness claim or that IPAD LLC somehow lacked bona fide intent to use its applied-for mark. Given RxD's disinterest in distinctiveness and intent to use prior to the Motion, RxD cannot now claim that the evidence is deficient in that respect.

The issues that RxD now seeks to raise were never addressed nor raised in these Proceedings. Allowing RxD to inject them at this unconscionably late date would fundamentally change the case, requiring that discovery be reopened so that IPAD LLC could have the "opportunity to present evidence

[17] As relevant to the present Motion, RxD identifies Document Request 39 (correspondence with Steve Jobs). (Mot at 2.) While the Board granted RxD's motion to compel on this request, it limited the grant "[t]o the extent responsive documents are in [IPAD LLC's] possession, custody, or control"; otherwise, RxD "must seek their production pursuant to a subpoena" to Apple. (D.E. 47 at 11.)

. . . to refute or explain the [evidence] on which opposer relies[.]"[18] *See Black & Decker*, at *3. For example, the deadline for expert disclosures in this Proceeding was more than a year ago (D.E. 30), but IPAD LLC would have to be afforded an opportunity to submit expert survey evidence to rebut RxD's mere descriptiveness claims. *See, e.g.*, *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985). Presumably, RxD would seek the opportunity to submit rebuttal reports in response to any such evidence. The Board also would need to extend the case schedule even further to permit IPAD LLC to submit a new, and heretofore unnecessary, round of summary judgment briefing to address the new claims and evidence. All of this would impose significant costs in terms of time, effort, and expense, taxing the parties and the Board, and would significantly delay resolution of these long-pending Proceedings. *See Pacamore Bearings, Inc. v. Minebea Co.*, 892 F. Supp. 347 (D.N.H. 1995) (denying motion where some elements of new claims would require discovery into matters not previously part of the action, which was likely to further delay the proceedings and might require additional experts). For these reasons, the Board routinely finds motions filed in similar postures to be prejudicial.[19] The same is warranted here.

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[18] RxD argues that there is no prejudice because the necessary evidence rests solely with IPAD LLC and Apple, and that each party has been given ample opportunity to disclose the relevant information requested. (Mot. at 8.) RxD's cites *American University v. Van Niekerk*, 2003 WL 22970623, at *2 & n.4 (T.T.A.B. Dec. 15, 2003) (non-precedential), but that case is distinguishable because the decision expressly hinged on the fact that discovery had ***not*** closed when petitioner moved for leave to amend, and the parties jointly stipulated to extension of discovery. IPAD LLC opposes further extensions to the calendar, which has already stretched on for years, and re-opening and extending discovery, particularly in light of the fact that IPAD LLC's fully briefed and dispositive summary judgment motion is pending.

[19] *See, e.g.*, *Int'l Fin. Corp.*, 2002 WL 1258278, at *7–8 (finding prejudice where "opposer waited over two years, and only in response to applicant's motion for summary judgment" after close of discovery); *Together Nets.*, 2015 WL 9906649, at *2 (finding prejudice where filed six weeks after close of discovery and there was no reason why descriptiveness claim could not have been asserted earlier); *United Homecare*, 2013 WL 11247709, at *2 (finding prejudice where filed after close of discovery, fourteen months after receiving discovery responses, and before plaintiff's pre-trial disclosure period); *Virgin*, 2012 WL 12517279, at *2; *Media Online*, 2008 WL 4419361, at *3 (finding prejudice where filed during pendency of motion for judgment on the pleadings, and where movant had ample time to move earlier); *Black & Decker*, 2007 WL 894416, at *3 (finding prejudice where Board could only avoid prejudice by re-opening discovery, and movant received relevant discovery responses two years prior).

D. RxD'S Motion Was Filed in Bad Faith to Salvage Meritless Proceedings

Leave to amend may also be denied where it is sought in bad faith, to avoid adverse rulings, or with dilatory motives. *Foman*, 371 U.S. at 182; *Trek Bicycle*, 2001 WL 1869327, at *2; *Acri v. Int'l Ass'n of Machs. & Aerospace Workers*, 781 F.2d 1393, 1398–99 (9th Cir. 1986) (affirming denial where filed to avoid ruling on summary judgment motion); *Ferguson v. Roberts*, 11 F.3d 696, 707 (7th Cir. 1993) (affirming denial where delayed until month before close of discovery, noting "seemingly dilatory nature of the request" and "concern[] that this was a tactic" to delay trial); *Windsor Card Shops v. Hallmark Cards, Inc.*, 957 F. Supp. 562 (D.N.J. 1997) (denying where movant could have alleged in original complaint, but waited until apparent that it could not prevail); *Hughes Aircraft Co. v. Nat'l Semiconductor Corp.*, 857 F. Supp. 691 (N.D. Cal. 1994) (denying where new claims had questionable merit, and prior tactics raised issue of bad faith); *Reisner v. Gen. Motors Corp.*, 511 F. Supp. 1167 (S.D.N.Y. 1981) (denying where filed to forestall summary judgment), *aff'd* 671 F.2d 91 (2d Cir. 1982).

Here, RxD's inexcusably delayed effort to add futile claims is a desperate, transparent attempt to avoid disposition on summary judgment in IPAD LLC's favor. IPAD LLC's summary judgment motion systematically demonstrated the frivolousness of RxD's case as a matter of law. (*See generally* D.E. 52.) Seeing the writing on the wall, RxD engaged in an eleventh-hour issue-spotting exercise to conceive new claims that would perpetuate these meritless Proceedings. But a motion to amend cannot be founded on the belated conception of new legal theories premised on long-known facts. *See, e.g.*, *Rhodes v. Amarillo Hospital Dist.*, 654 F.2d 1148, 1154 (5th Cir. 1981) ("[R]etention of a new attorney able to perceive or draft different or more creative claims from the same set of facts is itself no excuse for the late filing of an amended complaint."). RxD's Motion should be denied on this basis as well.

The Board should not reward RxD's inexcusable maneuverings. If the Board were to grant the Motion, then it would signal to the world that frivolous cases can defy or delay judgment simply by bringing successively frivolous claims and litigating them in dawdling, piecemeal fashion. Incentivizing behavior like RxD's would result in the Board's dockets becoming clogged with overripe cases propped up by untimely and frivolous "new" legal theories, which would tax the Board's resources and disserve

other litigants' rights to a "speedy and inexpensive" disposition on the merits. *Rehab. Inst. of Pittsburgh*, 131 F.R.D. at 102.

CONCLUSION

For the foregoing reasons, IPAD LLC respectfully requests that the Board deny RxD's Motion.

Respectfully submitted,

Dated: April 21, 2016

/s/ Allison W. Buchner

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ATTORNEYS FOR APPLICANT
IP APPLICATION DEVELOPMENT LLC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RXD MEDIA, LLC,	:	
	:	
Opposer,	:	
	:	
v.	:	**Opposition Nos. 91207333**
	:	**91207598**
IP APPLICATION DEVELOPMENT LLC,	:	
	:	
Applicant.	:	
	:	
	:	

DECLARATION OF PHIL HILL IN SUPPORT OF APPLICANT IP APPLICATION DEVELOPMENT LLC'S RESPONSE IN OPPOSITION TO RXD MEDIA, LLC'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION

I, Phil Hill, declare and state as follows:

1. I am an active member of the State Bar of New York and an attorney with the law firm of Kirkland & Ellis LLP, counsel of record for Applicant IP Application Development LLC ("IPAD LLC"). I am familiar with the files, documents, and correspondence in this case and submit this declaration concurrently with, and in support of, IPAD LLC's Response in Opposition to RxD Media, LLC's ("RxD") Motion for Leave to Amend Notice of Opposition (D.E. 57, the "Motion"), filed in this proceeding. I have personal knowledge of the matters stated in this declaration, and if called upon to testify, could and would do so competently.

2. Attached as Exhibit 1 is a true and correct copy of excerpts from the December 10, 2015 deposition of Thomas La Perle as the corporate representative of IPAD LLC and non-party Apple Inc. ("Apple") in his capacity as Director of the Trademark & Copyright Group at Apple and Manager of IPAD LLC, pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure. Portions of this transcript have been marked "TRADE SECRET AND COMMERCIALLY SENSITIVE" pursuant to Paragraph 1 of the Protective Order entered by the

Board on February 14, 2013 (D.E. 6 (approving D.E. 5, Stipulated Protective Order) (the "Board Protective Order")) and Paragraph 3 of the Protective Order entered by the U.S. District Court for the Northern District of California on December 8, 2015 (15-mc-80295 (N.D. Cal.), D.E. 3) at the request of Opposer RxD Media LLC ("RxD") and Apple, and those portions are redacted from the public filing.[1]

3. Attached as Exhibit 2 is a true and correct copy of excerpts from a document produced bearing bates numbers IPADLLC_001328–4508 that was produced in this action on October 30, 2015. This document is over 3,000 pages of screen captures of webpages showing Apple's use of the IPAD mark.

4. I have reviewed the search results that [redacted] and determined that IPAD LLC has produced over 3,000 pages of such documents in discovery in these proceedings.

5. Over the course of three years of discovery in these proceedings from December 15, 2012 and ended on January 6, 2016, IPAD LLC and non-party Apple produced 9,405 pages of documents, and RxD produced 1,943 pages of documents.

6. RxD served its First Set of Interrogatories (Nos. 1–18) and Requests for Production of Documents and Things (Nos. 1–19) on IPAD LLC on February 14, 2013, in response to which IPAD LLC served its responses and objections on March 21, 2013, with amended responses and objections served on November 1, 2013. IPAD LLC served additional supplemental responses (to a subset of those prior responses and objections) on October 30, 2015 and December 10, 2015.

7. RxD served its Third Set of Interrogatories (Nos. 19–29) on IPAD LLC on

[1] Pursuant to Rule 412.04 of the Trademark Trial & Appeal Board of Manual of Procedure, IPAD LLC has used yellow highlighting to identify the information in the confidentially filed versions of IPAD LLC's Response in Opposition to RxD's Motion for Leave to Amend Notices of Opposition and supporting documents that are redacted from the publicly filed versions.

December 29, 2014, in response to which IPAD LLC served its responses and objections on January 28, 2015, with additional supplemental responses (to a subset of those prior responses and objections) on October 30, 2015.

8. RxD served its Third Set of Request for Production of Documents and Things (Nos. 20–43) on IPAD LLC on December 29, 2014, in response to which IPAD LLC served its responses and objections on January 28, 2015.

9. RxD served its Fourth Set of Interrogatories (Nos. 40–44) on IPAD LLC on October 5, 2015, in response to which IPAD LLC served its responses and objections on November 4, 2015.

10. RxD served its First Set of Requests for Admission on IPAD LLC on March 31, 2015, in response to which IPAD LLC served its responses and objections on November 4, 2015, with an amended set of responses and objections (to a subset of those prior responses and objections) on December 16, 2015.

11. RxD served subpoenas for documents and testimony upon non-party Apple on October 19, 2015, in response to which Apple timely served objections and responses on November 2 and 6, 2015. Attached as Exhibit 3 is a true and correct copy of Apple's November 6, 2015 objections and responses, which has been marked "TRADE SECRET AND COMMERCIALLY SENSITIVE" pursuant to Paragraph 1 of the Board Protective Order. RxD also served a substantially duplicative subpoena on non-party Douglas Vetter, an employee of non-party Apple, on November 4, 2015, in response to which Apple timely served objections and responses on November 23, 2015. RxD did not seek to meet and confer to resolve any of Apple's objections or to provide any further basis for the relevance of RxD's requests.

12. Mr. Vetter was deposed on Apple's behalf on February 10, 2016, pursuant to the January 8, 2016 order entered by the U.S. District Court for the Northern District of California, 15-mc-80291 (N.D. Cal.) (D.E. 27), which granted in part and denied in part, Apple's request to quash RxD's subpoena, limiting Mr. Vetter's deposition to just two hours. Attached as Exhibit 4 is a true and correct copy of the Northern District of California Order.

13. Both IPAD LLC and RxD served document productions on the last day of discovery, January 6, 2016. IPAD LLC made three additional minor or courtesy productions on January 21, February 1, and February 8, totaling four documents, including a Bates-stamped courtesy copy of [redacted] in connection with the Board's examination of RxD's trademark application. RxD does not cite any of these documents as relevant to the Motion.

14. After the close of discovery, RxD also made six additional productions, on January 7, January 21, January 28, February 5, February 9, and February 23, totaling 90 documents.

15. I declare, under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on April 21, 2016, at New York, New York.

/s/ Phil Hill
Phil Hill, Esq.

RxD Media, LLC v. IP Application Development LLC
Opposition Nos. 91207333, 91207598

APPLICANT'S EXHIBIT 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RXD MEDIA, LLC, Opposer,	)	
vs.	)	Opposition No. 91207333 91207598
IP APPLICATION DEVELOPMENT LLC, Applicant.	)	

TRADE SECRET AND COMMERCIALLY SENSITIVE

UNDER PROTECTIVE ORDERS

VIDEOTAPED 30(b)(6)DEPOSITION OF APPLE INC.

DESIGNEE: THOMAS R. LaPERLE

Palo Alto, California

Thursday, December 10, 2015

Reported By:

Jenny L. Griffin, CSR 3969

Job No.: 10020805

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

RXD MEDIA, LLC, Opposer,	)	
vs.	)	Opposition No. 91207333 91207598
IP APPLICATION DEVELOPMENT LLC, Applicant.	)	

Videotaped deposition of THOMAS R. LaPERLE, taken on behalf of Opposer, at Kirkland & Ellis, 3330 Hillview Avenue, Palo Alto, California, commencing at 9:00 a.m., Thursday, December 10, 2015, before Jenny L. Griffin, RMR, CRR, CSR 3969.

[redacted]

Q. Have you ever spoken with Peter Oppenheimer about this opposition matter?

A. No.

Q. How about Phil Schiller? Have you ever spoken to Mr. Schiller about this matter?

A. No.

Q. Have you ever spoken to Dan Cooperman about this matter?

A. No.

Q. And Douglas Vetter?

A. Yes.

Q. Do you recall when IP Application Development LLC was established?

A. I believe it was in January of 2010.

Q. Does January 11, 2010, sound right?

A. I don't know the exact date.

Q. All right. We can check that. But January of 2010 you believe?

A. I believe that's correct.

[redacted]

Q. Fair question.

[redacted]

Q. And who was the outside counsel?

A. It was Dechert.

A. That's correct. Well, that's my -- I definitely hadn't seen this. I don't recall seeing that either. [redacted]

Is that a -- well, I'll just ask it that way.

[redacted]

Q. Okay. Without revealing any privileged information, did the written opinion you have synopsize the underlying data?

MS. CENDALI: Objection to form. Vague. Overbroad.

[redacted]

RxD Media, LLC v. IP Application Development LLC
Opposition Nos. 91207333, 91207598

APPLICANT'S EXHIBIT 2

Develop your own interactive materials with iBooks Author. Organize and deliver your lessons with iTunes U. Discover a world of possibilities with iPad.
Learn more about using iPad in your classroom

Apps, books, and more.

When it comes to finding content for your lessons, iPad has something for everything you teach. And for everything your students want to learn. There are hundreds of thousands of apps, interactive textbooks, videos, and podcasts that cover every subject and grade level. The App Store, iBooks, and iTunes U make it simple to navigate and find what you need. And new resources are added every day.
Learn more about education content for iPad

Teaching with iPad.

See how teachers are using iPad and a breadth of content from iTunes to transform learning and build deep understanding in their classrooms. Get an inside look at inspiring lessons and find practical and effective tips from real teachers on how to harness the resources at your fingertips to take your lessons to the next level.

Learn more from real teachers

Apple and Education.

We believe in the power of technology to transform classrooms. Learn more >

Mac

Powering the classroom since 1984.

Learn more

Special Education

Possibility is built right in.

Learn more

Real Stories

Innovative teachers, inspired learners.

Learn more

IT

Manage devices and content for your students.

Learn more

iPad in Business

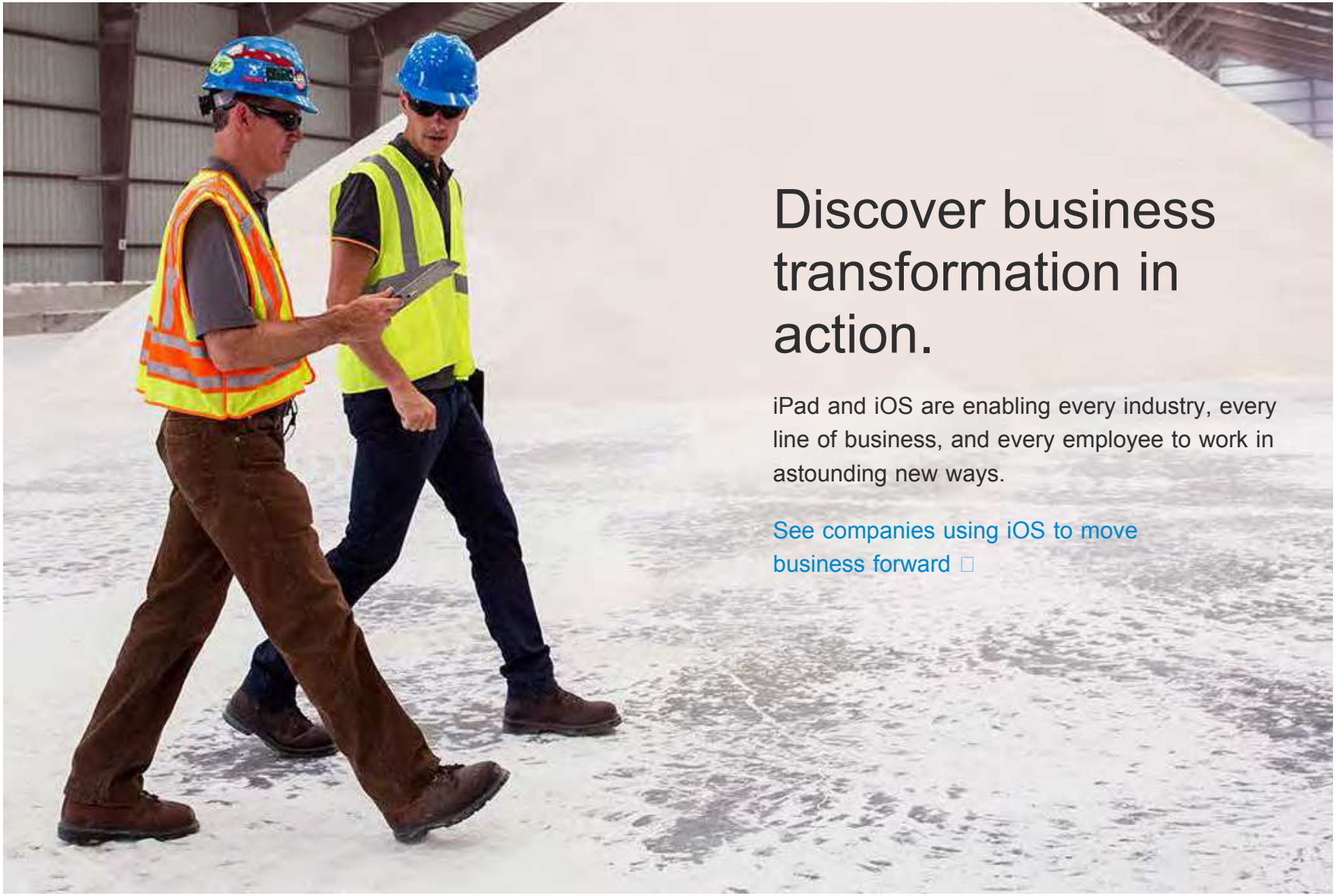
Moving business forward.

When you put iPad and iOS technology at the center of your business strategy, a new era of possibilities begins. One where employees are empowered with devices they love, productivity is effortless, and innovation happens in the moment. iPad and iOS enable your business to operate in ways never before possible.

Better than ever for business.

With multitasking on iPad and new management tools for IT in iOS 9, delivering great security and the best user experience has never been easier. Now businesses have even more ways to transform how they work.

See what's new in iOS 9 for business


Discover business transformation in action.
iPad and iOS are enabling every industry, every line of business, and every employee to work in astounding new ways.
See companies using iOS to move business forward

Reimagine work with next-gen apps.

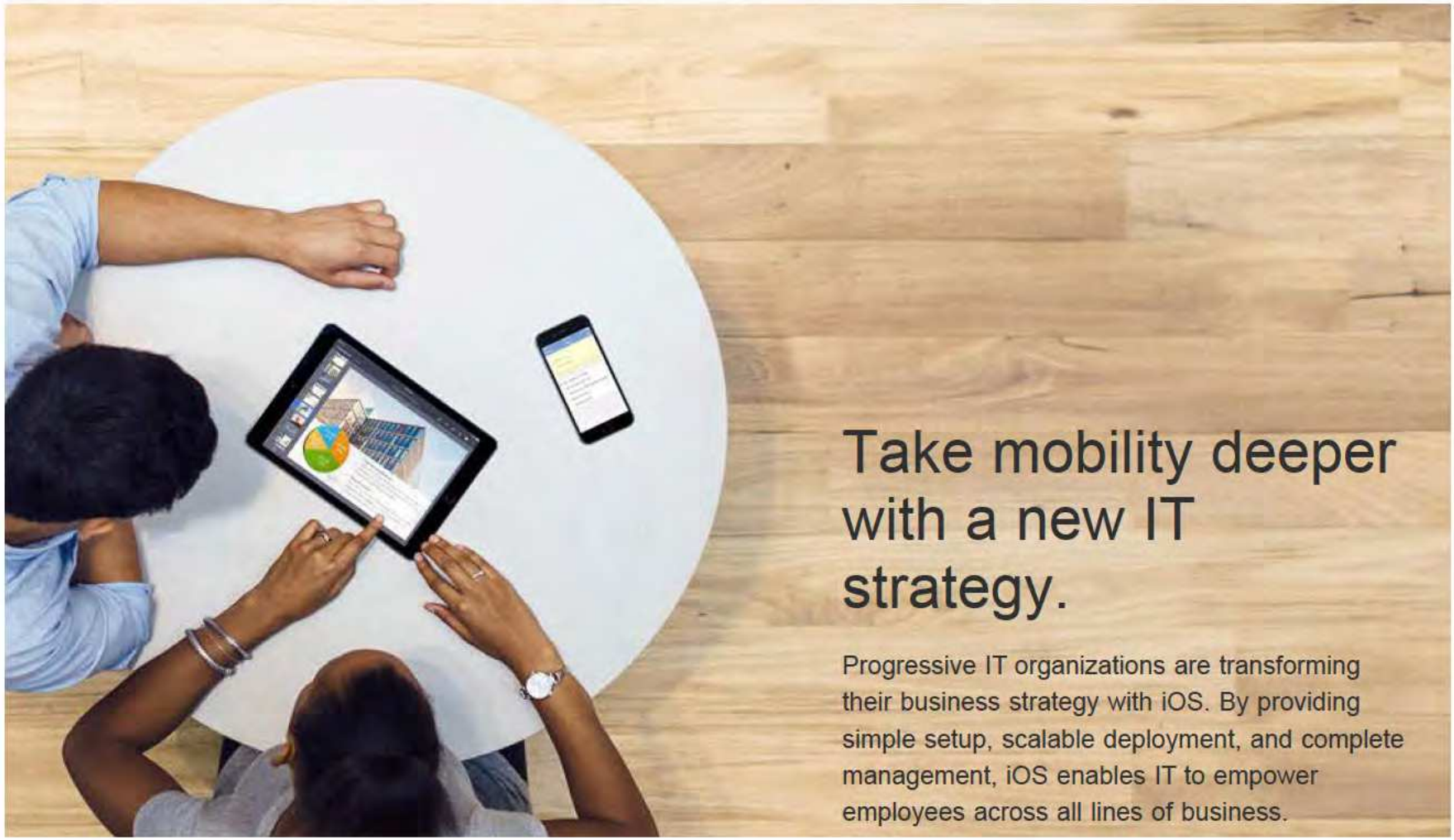
iOS technology is fueling a whole new genera
apps that bring more power, more insights, ar
capability to your business than ever before.

Explore next-gen apps for business

+ IBM

Apple and IBM are redefining mobility with a r
class of apps made exclusively for iOS. When
world's best mobile technology works together
big data and analytics, great things happen.

Discover IBM MobileFirst for iOS apps



Take mobility deeper with a new IT strategy.

Progressive IT organizations are transforming their business strategy with iOS. By providing simple setup, scalable deployment, and complete management, iOS enables IT to empower employees across all lines of business.

Apple and Cisco

Working together to optimize the mobile experience on corporate networks.

Read the press release

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The best place to learn about Apple products.

The Apple Store is much more than a store. It's a place to learn about your Apple device. And a place to discover your creative side. We offer free workshops for people of all experience levels, along with youth programs like Apple Camp and Field Trip.

Workshops · Youth Programs ·

Learn the basics and more at free workshops.

Explore everything you can do on Mac, iPad, iPhone, or iPod. Create slideshows with Photos. Edit movies with iMovie. Or discover ways to make your documents, spreadsheets, and presentations look their absolute best.

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Our workshops.

Apple Watch Basics

Bring your Apple Watch — along with your iPhone — for an entry-level tour. We'll show you how to get started with notifications, Glances, Digital Touch, and more.

Discover Apps for Apple Watch

Join us for a hands-on lesson in getting the most from your watch. Bring your Apple Watch and iPhone or we'll supply a watch for you to use, and follow along as we explore apps designed just for Apple Watch. Discover new ways to use the built-in apps you're familiar with like Mail, Messages, and Maps. We'll also show you how to personalize your app layout, notifications, and more.

Mac Basics

Come get an introductory tour of your Mac. We'll show you the basics of navigating, getting organized, and keeping your software up to date.

Personalize Your Mac

Already familiar with the basics? Come to this workshop to discover great ways to personalize your Mac. Find out how to customize your desktop or screen saver and learn handy keyboard shortcuts, gestures,

and more.

iPhone & iPad Basics

Come get an introductory tour of your iPhone or iPad. We'll show you the basics of navigating, getting organized, and keeping your device up to date.

Personalize Your iPhone & iPad

Already familiar with the basics? Come to this workshop to discover great ways to personalize your device. We'll show you how to customize your Home screen, find great apps, and personalize your settings.

Stay Connected

Discover great new ways your devices can help you stay in touch using FaceTime, Messages, Find My Friends, and more.

iCloud Basics

iCloud helps you access your files across iPhone, iPad, Mac, and the web. Learn great ways to share files with friends and family, and get peace of mind with backups and automatic syncing.

iPhone Photography

Learn how to capture and edit great-looking photos using the camera and tools already on your iPhone.

Enhance and Share Your Photos on iPhone and iPad

Come learn the key elements of great photo editing, from quick fixes to fine adjustments. Feel free to bring your own device and follow along as we discuss the editing and sharing features of the Photos app and discuss the most popular App Store photo apps.

Enhance and Share Your Photos on Mac

Come learn the key elements of great photo editing, from quick fixes to fine adjustments. Feel free to bring your Mac and follow along as we discuss photo editing and sharing features.

Create Your Own Movie on iPhone or iPad with iMovie

Learn the basics of moviemaking, from shooting stunning HD video with iPhone or iPad to making your first cut in iMovie. We'll also show you great ways to share your finished movie with the world.

Enhance Your Movie Editing with iMovie for Mac

Already familiar with iMovie basics? In this intermediate workshop, you'll learn some of the best tips and tricks for making precision edits and adding stunning effects to your video.

Space for workshops is limited and available on a first-come, first-served basis.

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FASTER CELLULAR CONNECTIONS

Apple SIM. More choices for staying connected.

With Apple SIM installed in your iPad Air 2 with Wi-Fi + Cellular, you can purchase a cellular data plan right on your iPad. Whether you're in the U.S. or traveling to more than 90 countries and territories supported by Apple SIM partners, you can easily choose a plan with no long-term commitment. Apple SIM gives you more flexibility and more choices for getting cellular data whenever you need it, for however long you need it. And when you return to the U.S., it's easy to switch back to your local plan.

Apple SIM partners[3]

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Create your own mobile hotspot.

With Personal Hotspot on your Wi Fi + Cellular model, you can easily create a mobile hotspot for other devices. For example, say you're with some friends who want to get online with a laptop, but there's no Wi Fi. You can come to their rescue simply by turning on your hotspot in Settings, and voilà, they're ready to connect. And you're the hero.

iPad Air 2

Explore Buy Now

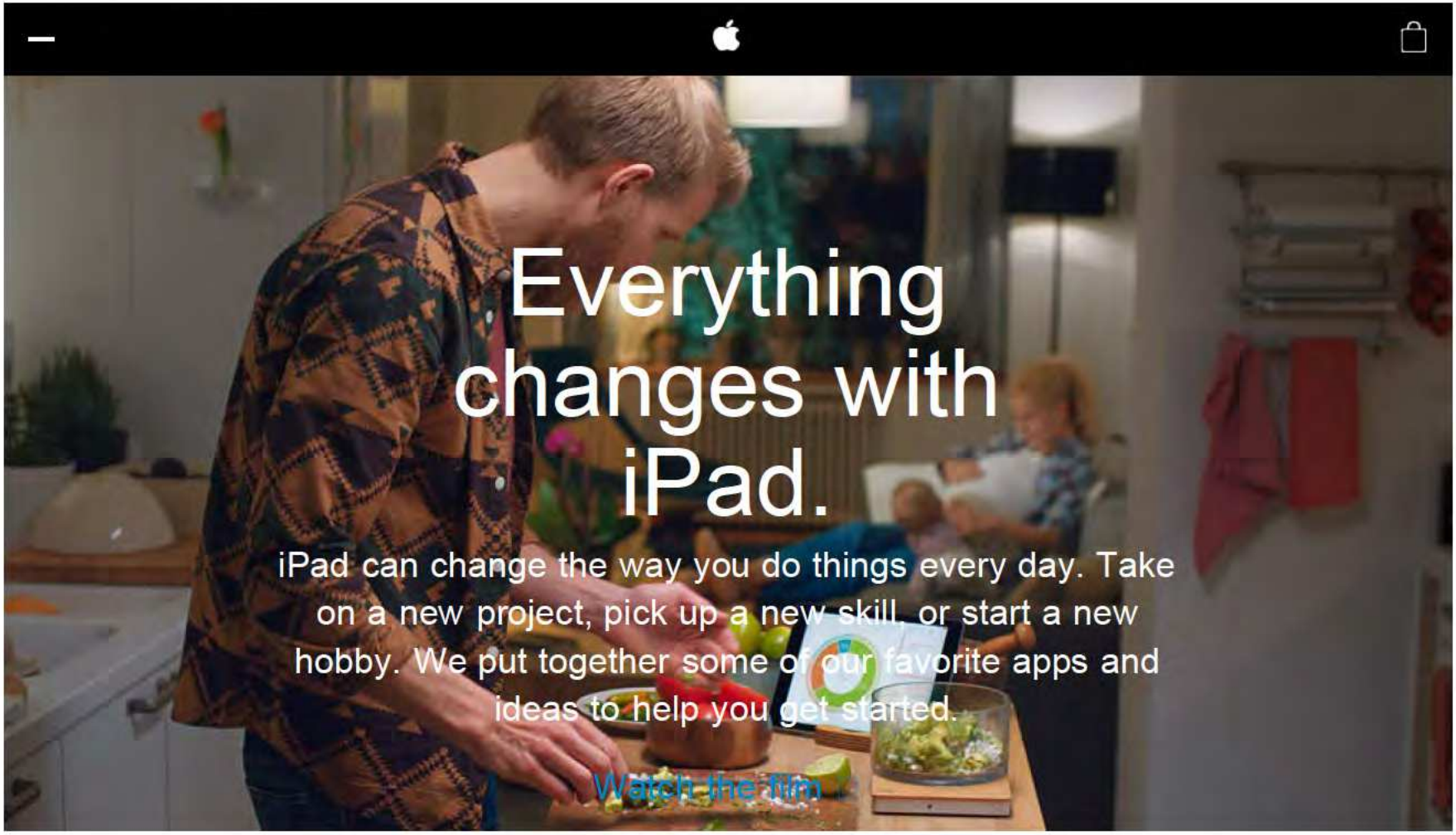
Apps

Designed for iPad. And everything you want to do with it.

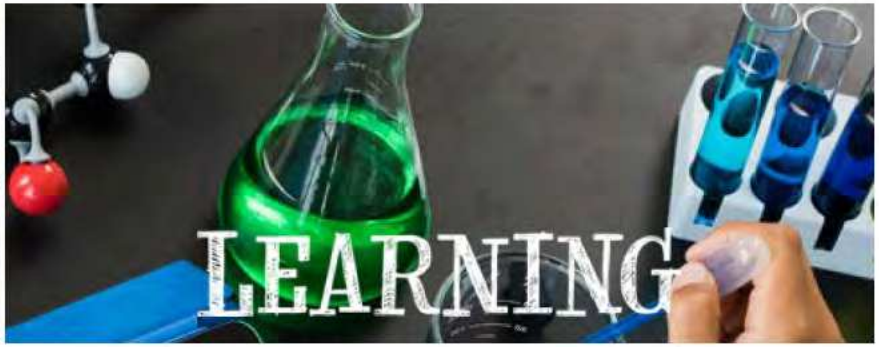
iPad apps are, true to their name, built just for iPad. And there are hundreds of thousands of them, designed to use every stunning inch of the Retina display and the power of the A8X chip. You'll find productivity apps that let you create presentations, build spreadsheets, manage your finances, and write and edit documents. As well as apps for photography, gaming, traveling, emailing, and managing your workouts. So whatever you're into, you'll find an iPad app to help you do it better.

Exclusively from Apple. Especially for iPad.

Every new iPad comes with Pages, Numbers, Keynote, iMovie, and GarageBand.* So you can be creative with your documents, spreadsheets, presentations, videos, and music right from the start. And all these apps are optimized for 64 bit architecture.


Everything changes with iPad.
iPad can change the way you do things every day. Take on a new project, pick up a new skill, or start a new hobby. We put together some of our favorite apps and ideas to help you get started.
Watch the film


Cooking


LEARNING


with iPad
Explore


with iPad
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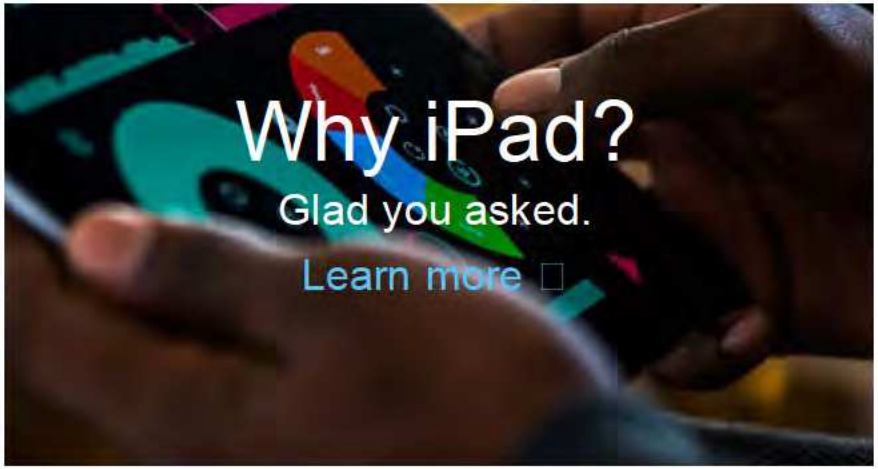
SMALL BUSINESS
with iPad
Explore


TRAVELING
with iPad
Explore



Which iPad is for you?

Compare iPad models

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Pick up today

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Learn more

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iPad Everything changes with iPad

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Apple TV and iPad
Watch and learn.

With Apple TV, you can use AirPlay to wirelessly stream the content on an iPad to any HDTV. Use it to lead a class brainstorm, or walk everyone through a presentation. Your students can connect with Apple TV just as easily, giving them the ability to share projects and other work on the big screen. And with iOS 8, students and teachers can also connect iPad to Apple TV without first connecting to the school network. This means anyone in the class can present or share their work even if they are not on the network or if Apple TV is on a different network.

iPad and Special Education
Ability is built right in.

iPad is a powerful learning tool for students with special needs. It comes with a screen reader, closed-captioned support, and other innovative accessibility features — right out of the box. For students with cognitive, physical, or other disabilities, iPad opens up incredible possibilities for learning.

Learn more about accessibility on iPad

iPad in Business

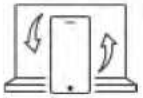
Business apps made extraordinary with iOS.

The next generation of business apps take advantage of unique iOS capabilities such as Extensions, iBeacon, Touch ID, Handoff, and more. These apps are streamlining workflows and making everyday tasks infinitely more productive. Discover the possibilities and reimagine how your business could work.

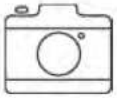
Extensions

Location Services

iBeacon



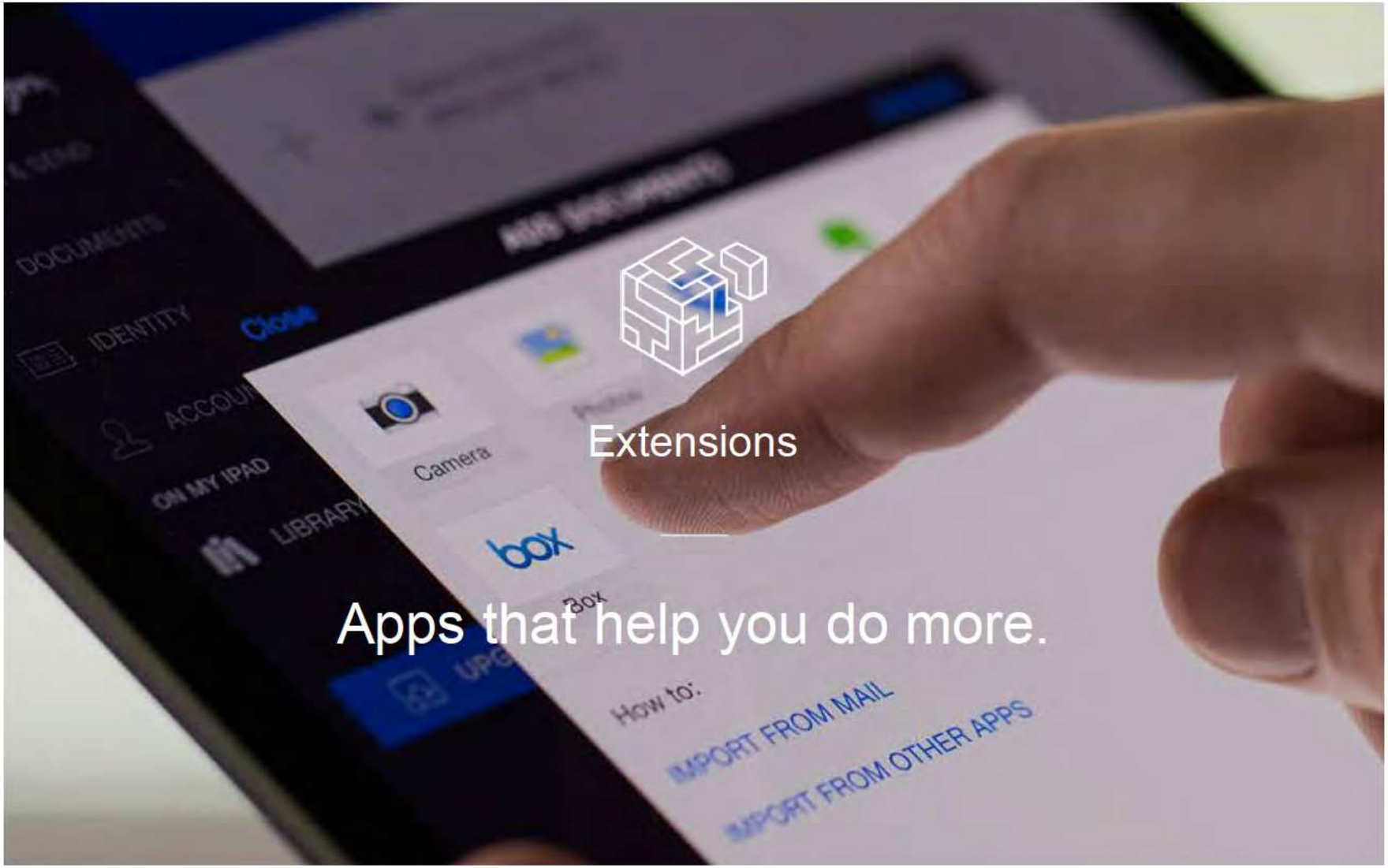
Handoff



Camera

AirPlay

Touch ID


Extensions
Apps that help you do more.
Camera
box
How to:
IMPORT FROM MAIL
IMPORT FROM OTHER APPS

Extensions let you do more with apps on iPad and iPhone. Work in one app while tapping into another app's functionality and content across iOS. View daily tasks in Notification Center, and share documents easily between apps. You can even create custom actions to extend your app's capabilities.

Tap into the information that matters most.

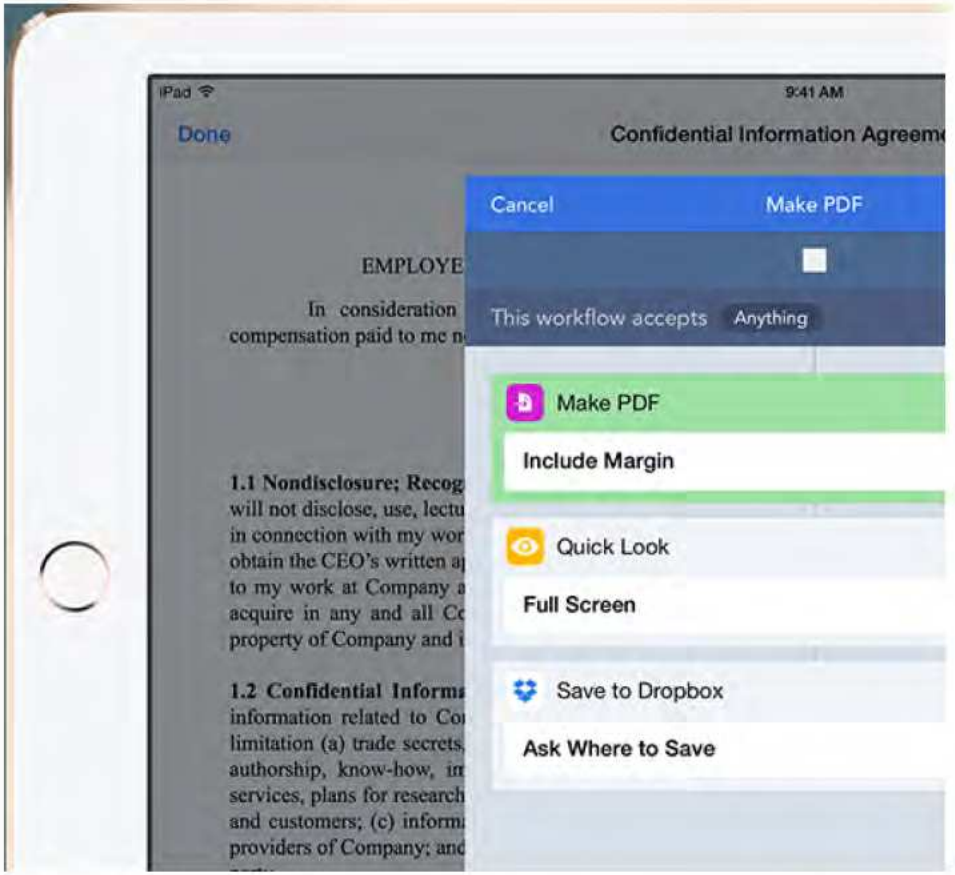
By swiping into the Today view in Notification Center, you can now view a quick summary of your information in Evernote. Easily see all your recent notes and checklists, or quickly access common functions of the app with a single tap.

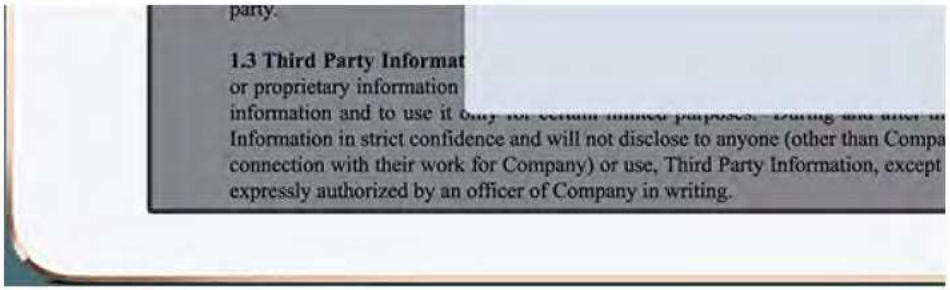
Evernote
View in App Store

Automate workflows across apps like never before.

Workflow lets you automate functions across other apps so you can be even more productive on iPhone and iPad. You can easily launch workflows from inside the app or from other apps using Workflow's Action extension.

Workflow
View in App Store

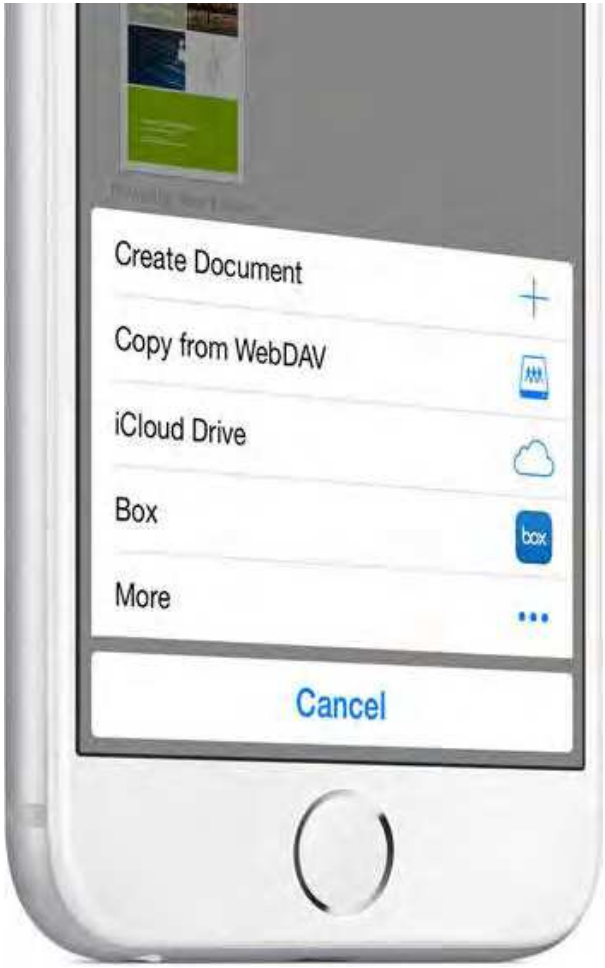



party.

1.3 Third Party Informat
or proprietary information
information and to use it
Information in strict confidence and will not disclose to anyone (other than Compa
connection with their work for Company) or use, Third Party Information, except
expressly authorized by an officer of Company in writing.

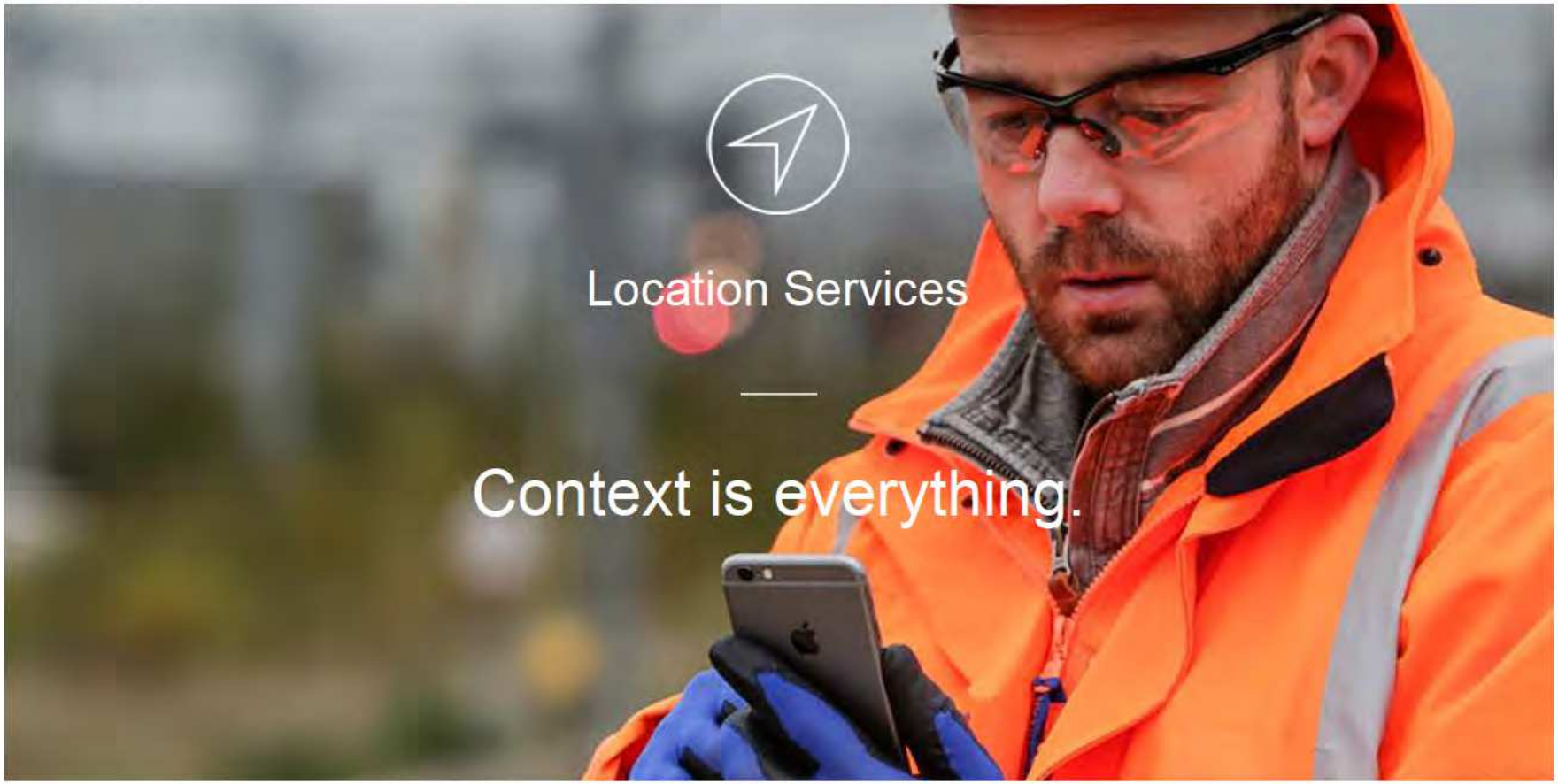
Work with content effortlessly.

Extensions make it possible for apps like Pages to import documents directly from Box. Now you don't need to leave the app you're in to get the documents you need.



Box

View in App Store

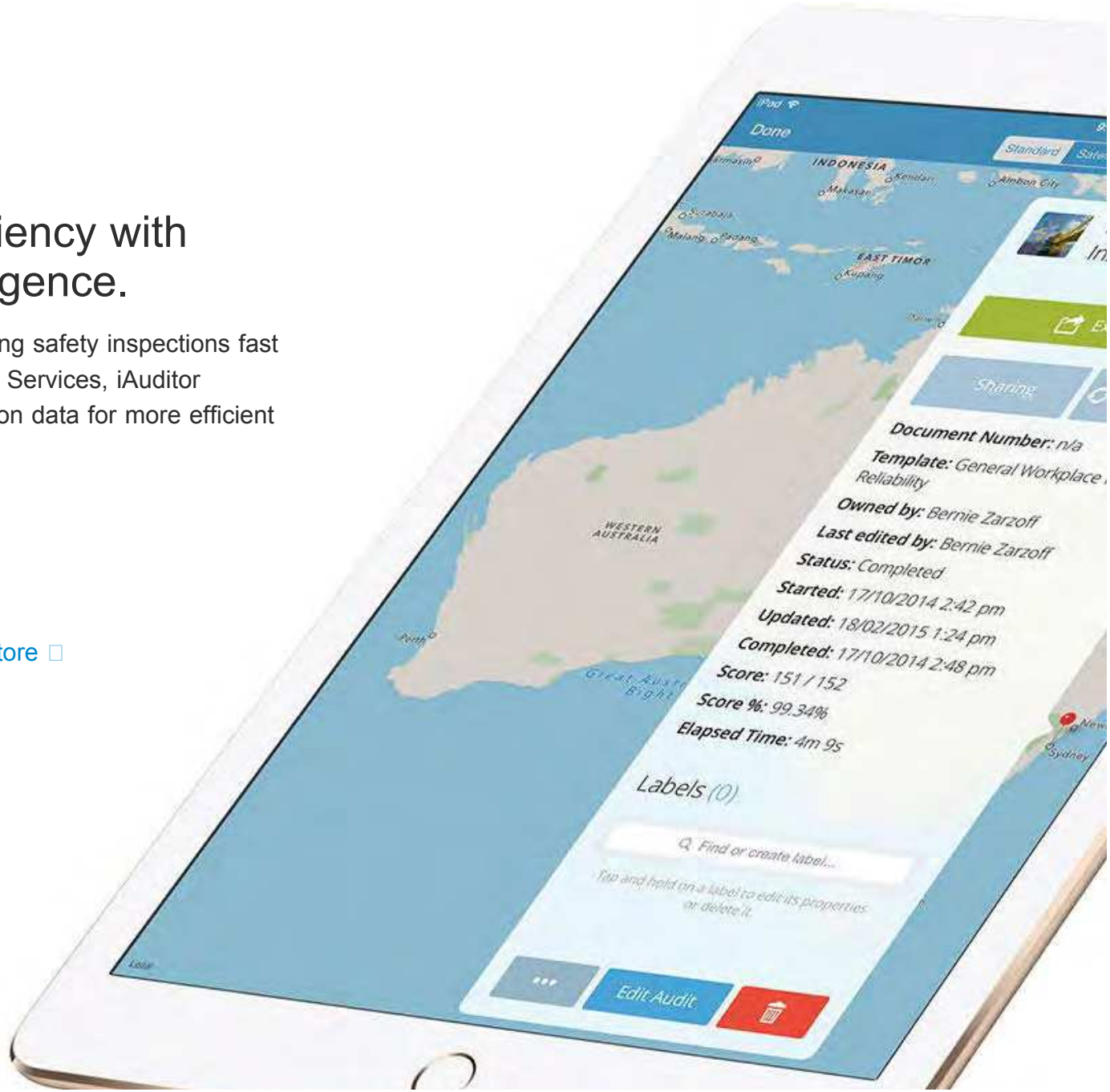


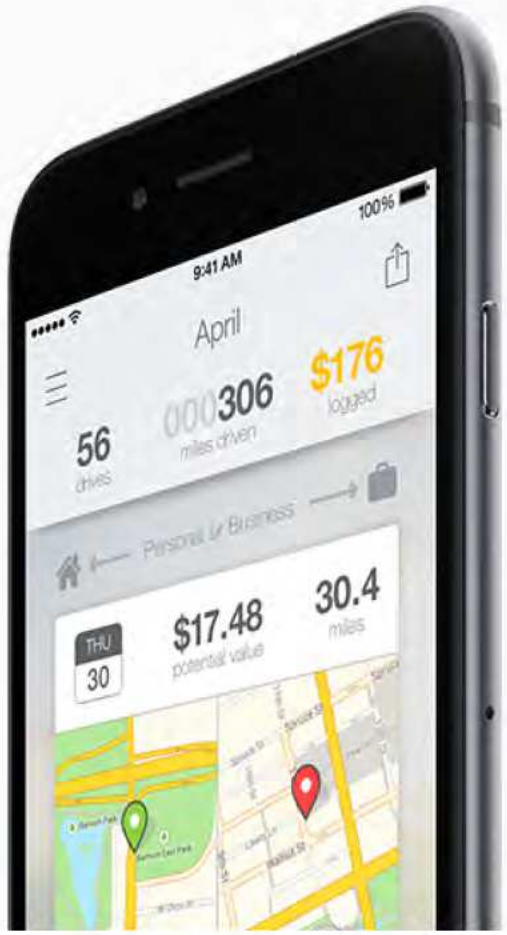
Location Services provides the context you need to get the right information at the right time. Make your day even more productive, whether that means navigating efficiently to a client's office or automatically capturing location information at an inspection site.

Increase efficiency with location intelligence.

iAuditor makes completing safety inspections fast and easy. With Location Services, iAuditor automatically logs location data for more efficient inspections.

iAuditor
View in App Store



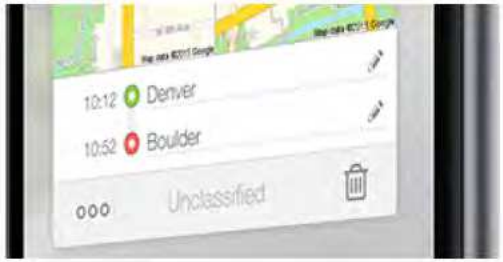


Detect mileage automatically.

MileIQ uses Location Services and smart-drive technology to detect your route, automatically track mileage, and calculate reimbursement. Minimize the effort needed to get reimbursed for your business travel.

MileIQ

View in App Store



Communicate your destination visually.

Skitch lets you annotate images and maps quickly, making it even easier to direct people where to go. By leveraging Location Services, Skitch lets you map your current location, mark it up, and go.

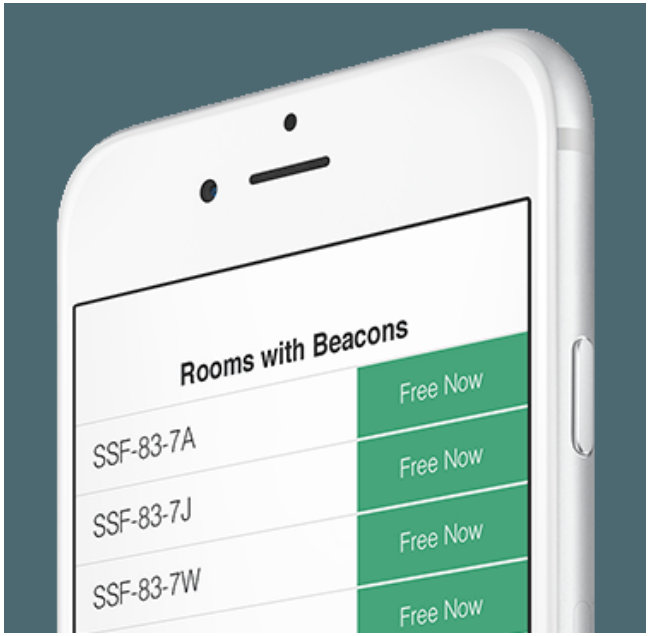
Skitch
View in App Store


iBeacon
The power of proximity.

iBeacon technology lets your iOS device sense proximity to a specific location, so you can do more with location awareness. The possibilities are limitless — from streamlining meeting room availability by automatically detecting when employees are present, to improving customer service by providing personalized messages to customers.

Meeting room efficiency.

Genentech built a custom app that lets employees check the availability of meeting rooms and book one instantly, right on iPhone. iBeacon technology detects when people are present in a meeting room, so that employees are never left wondering which rooms are in use and which are vacant.



Genentech SignalMe

Enterprise In-House App

Secure access without the hassle.

The Usher Security app uses iBeacon technology to manage employee access, without the need for physical badges or additional credentials.

Usher Security

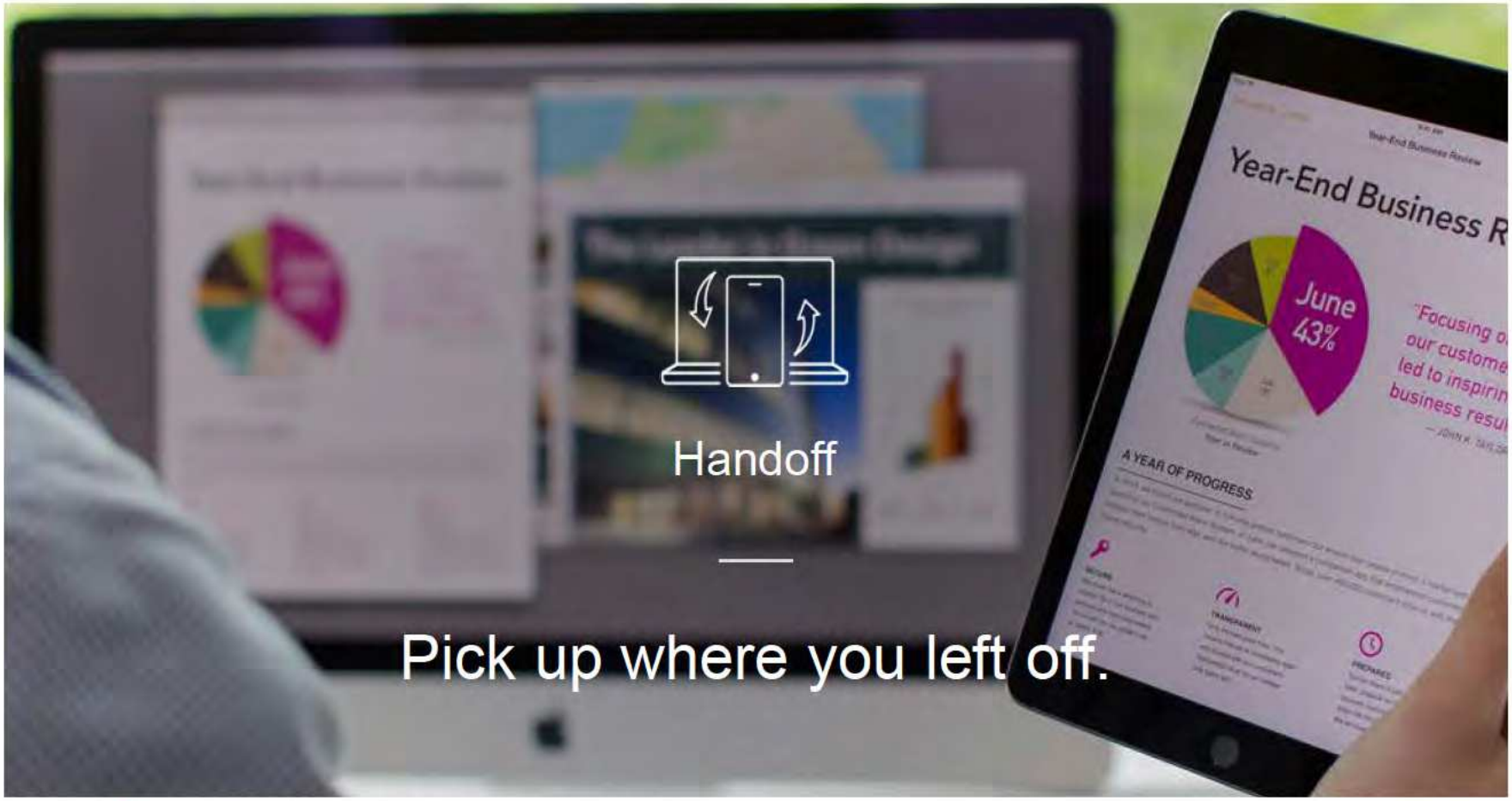
View in App Store

Customer service reimagined.

Sales Assist, an IBM MobileFirst for iOS app, uses iBeacon technology to identify a shopper's whereabouts on the store floor. Store associates can provide more efficient service and personalized recommendations to customers that have the store's app on their device.

Sales Assist

Explore IBM MobileFirst for iOS apps



Handoff lets you start an activity on one device and seamlessly continue on another device. So if you're running out the door, but haven't finished the work on your Mac, you can continue right on your iPad or iPhone. All you have to do is log in to both devices with the same iCloud account.

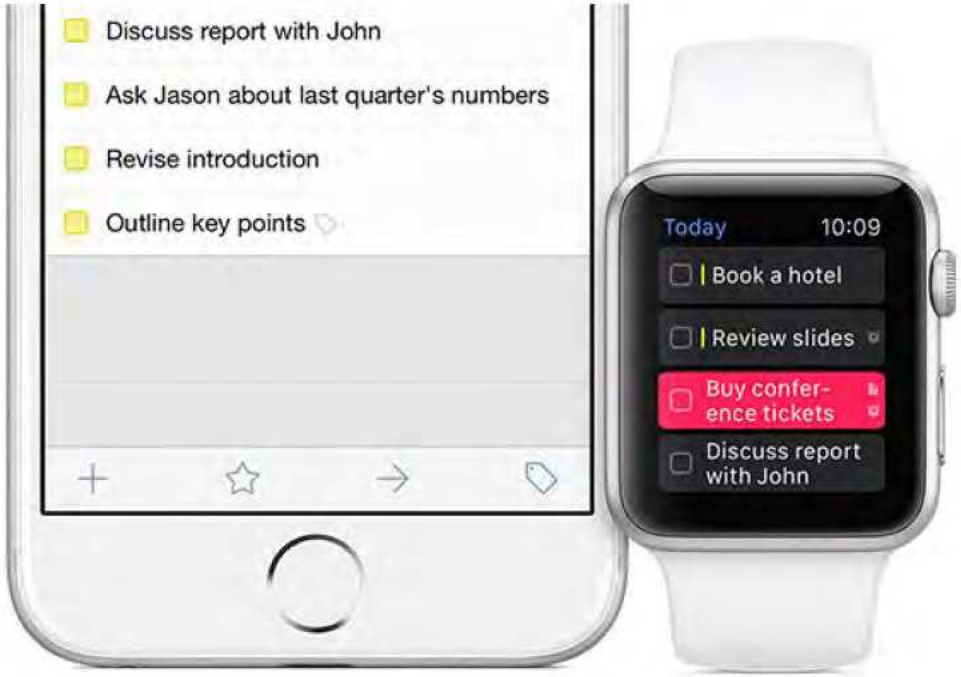
Manage your day seamlessly.

Things simplifies managing daily tasks, so you can move on to the next project quickly. And with Handoff, now you can start a list on your iPhone and mark your tasks complete as you go on

Apple Watch.

Things

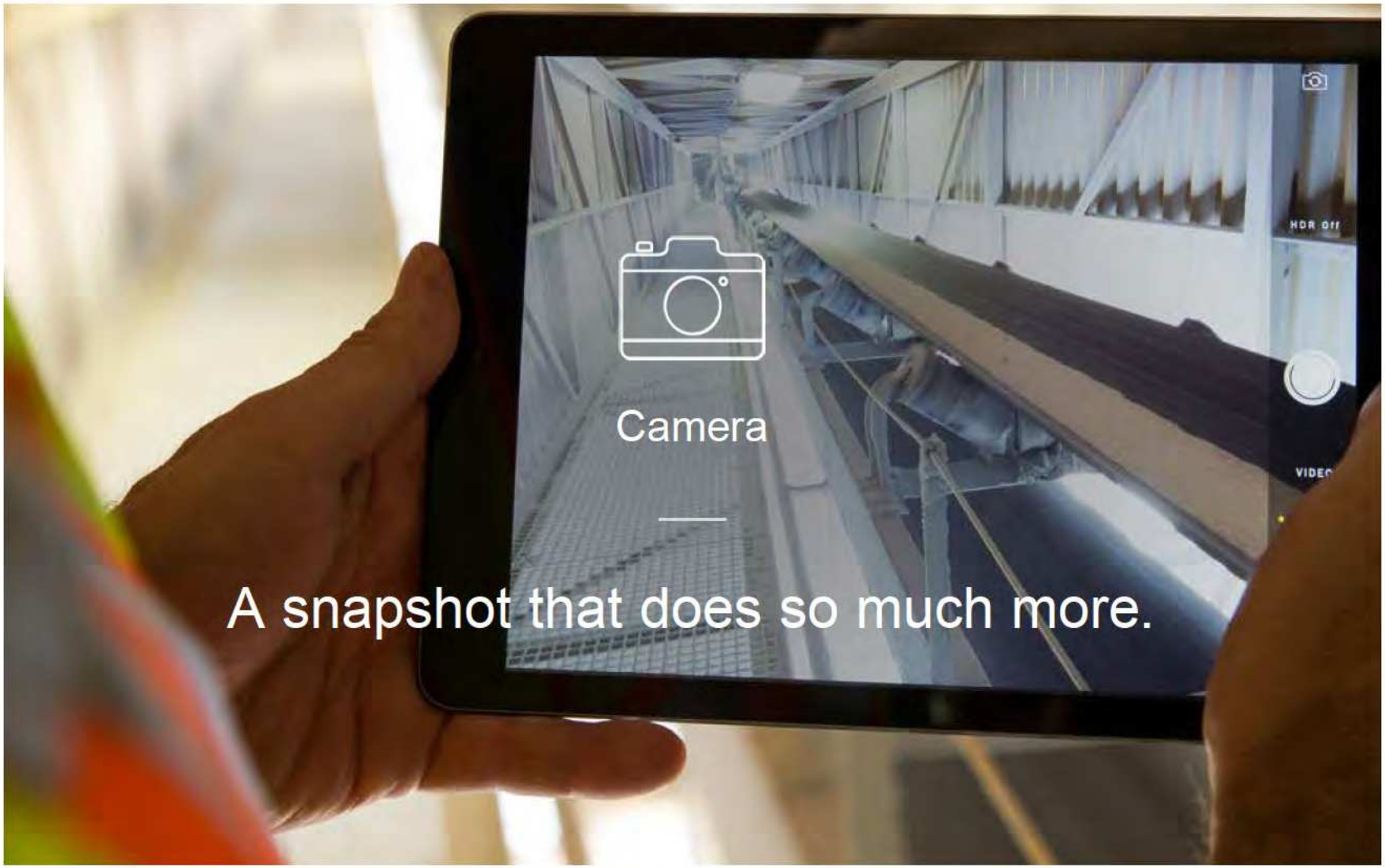
View in App Store



Take meetings on the go.

GoToMeeting makes it easy to join a meeting on iPhone or iPad when you're on the go, then hand off to your Mac once you reach the office.

GoToMeeting
View in App Store


HDR Off
Camera
A snapshot that does so much more.

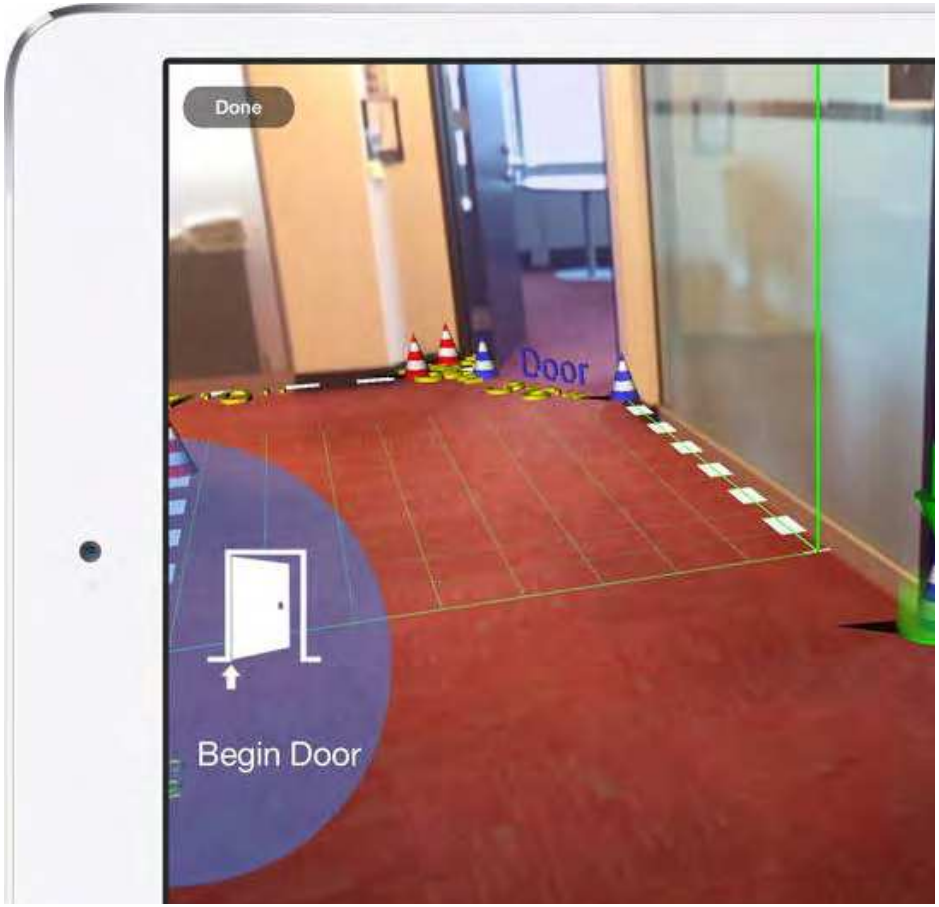
Use the built-in camera on iPhone and iPad in more innovative ways than ever before. Leverage Camera in apps to view augmented visualizations, simplify daily tasks, and even replace complex manual calculations — all with just a tap.

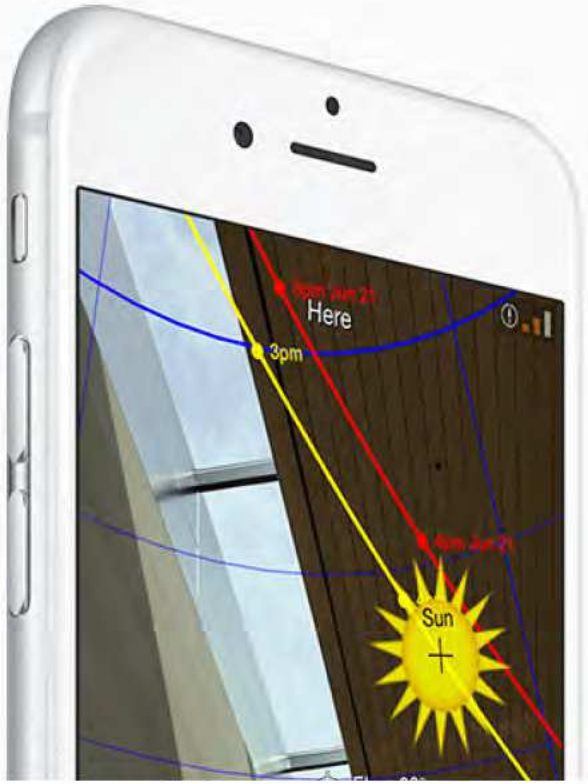
Visualizations made easy.

MagicPlan lets you measure rooms and draw floor plans just by taking a picture. You can add attributes and annotations to a snapshot to create an indoor map in minutes.

MagicPlan

View in App Store



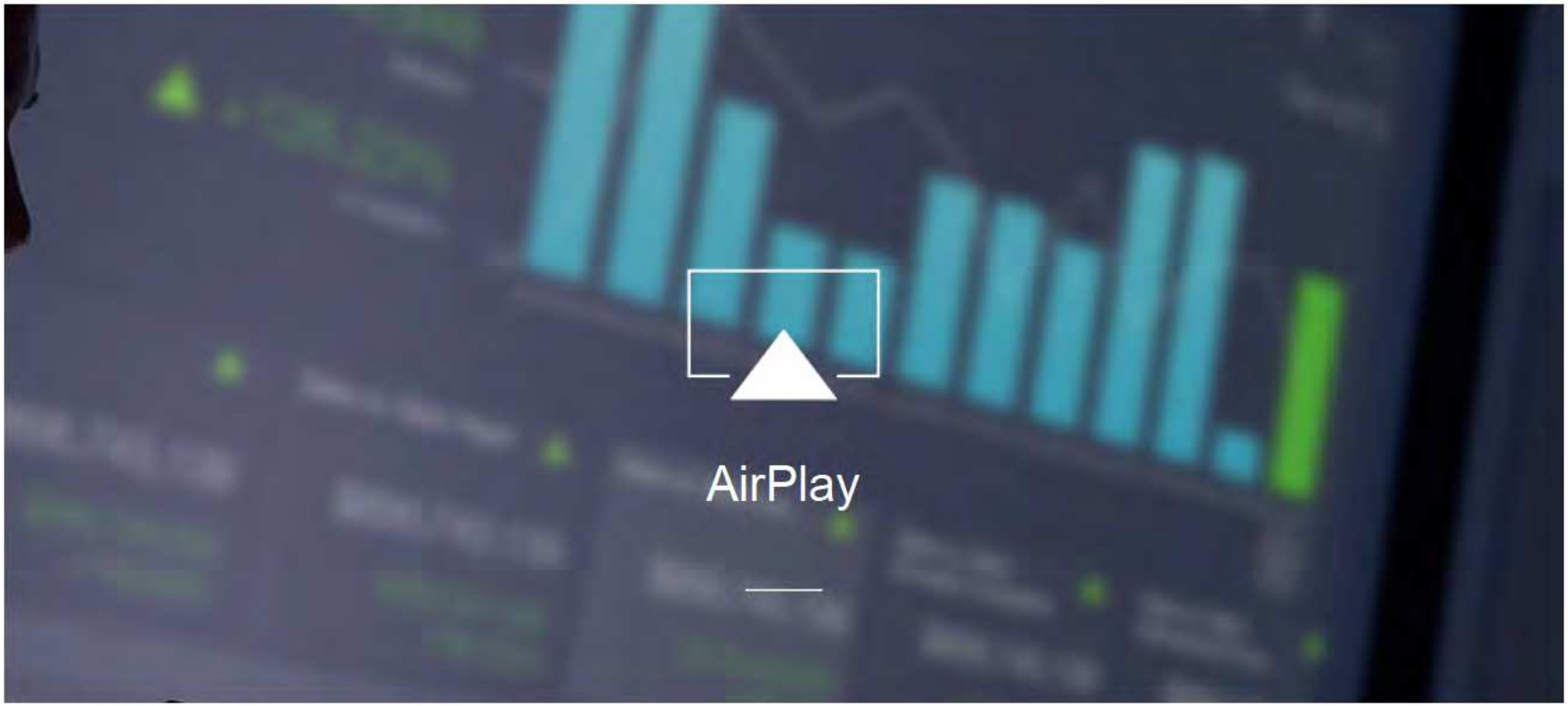


Interact in a whole new light.

Sun Seeker leverages the camera to easily view the sun's location and solar path. It's never been easier to plan around the perfect light conditions, whether you're designing architectural plans for optimal sun exposure or planning a photoshoot for the best time of day.

Sun Seeker

View in App Store



Take your great ideas further by sharing them with everyone around you. Easily share your work from an iOS device to Apple TV wirelessly by simply tapping into AirPlay, all without having to connect to your organization's network.

Presentations amplified.

Keynote makes it easy to create beautiful presentations, and AirPlay makes it super simple to share them with a group. Stream Keynote presentations wirelessly from any iOS device to Apple TV with AirPlay.

Keynote

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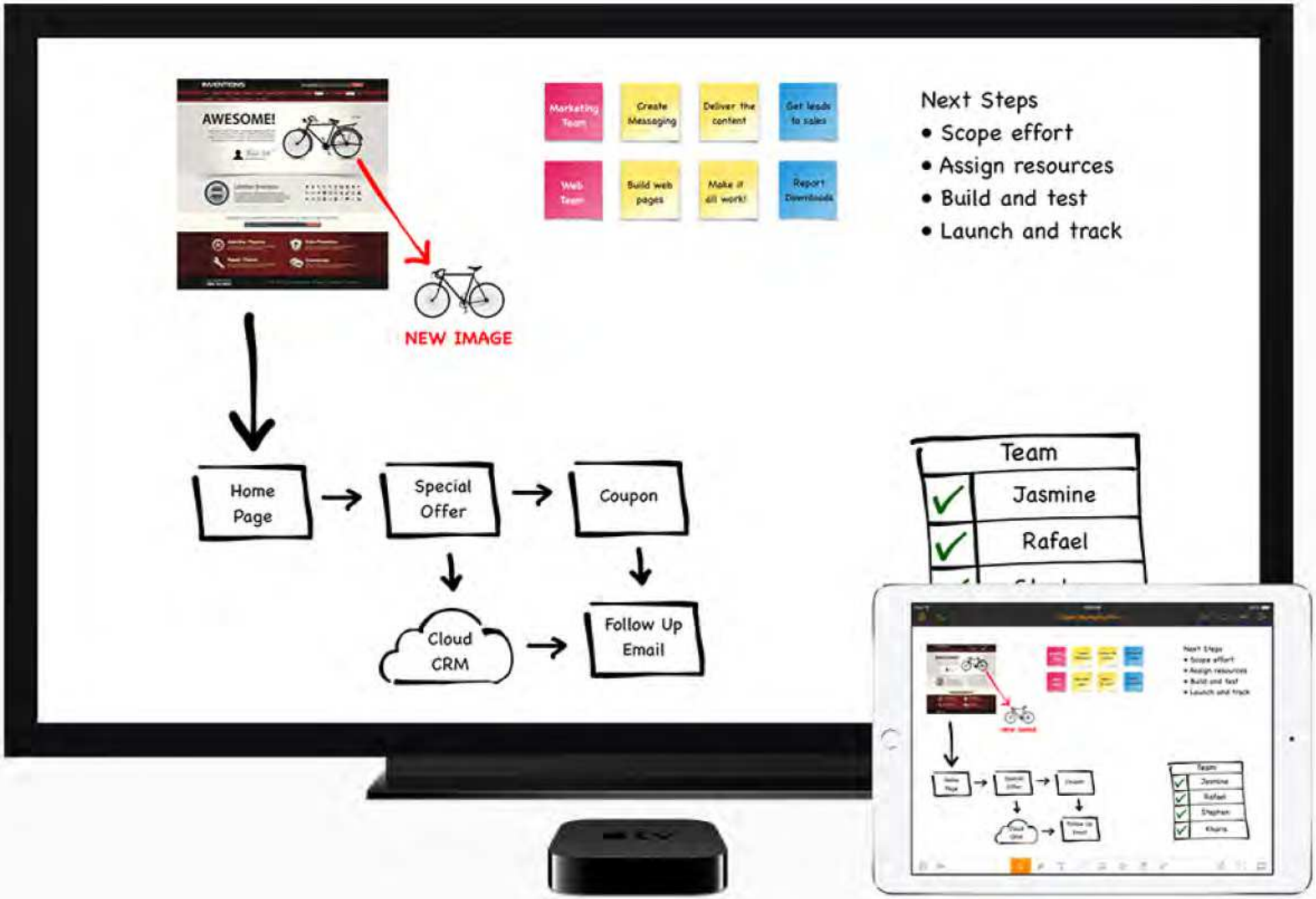

AWESOME!
NEW IMAGE
Marketing Team
Create Messaging
Deliver the content
Get leads to sales
Web Team
Build web pages
Make it all work!
Report Downloads
Next Steps
• Scope effort
• Assign resources
• Build and test
• Launch and track
Home Page
Special Offer
Coupon
Cloud CRM
Follow Up Email
Team
Jasmine
Rafael

Meetings on the big screen.

join.me makes meetings more effective — take meetings anywhere and dynamically whiteboard ideas directly from iPad. And now you can easily share your ideas, boards, and presentations with AirPlay.

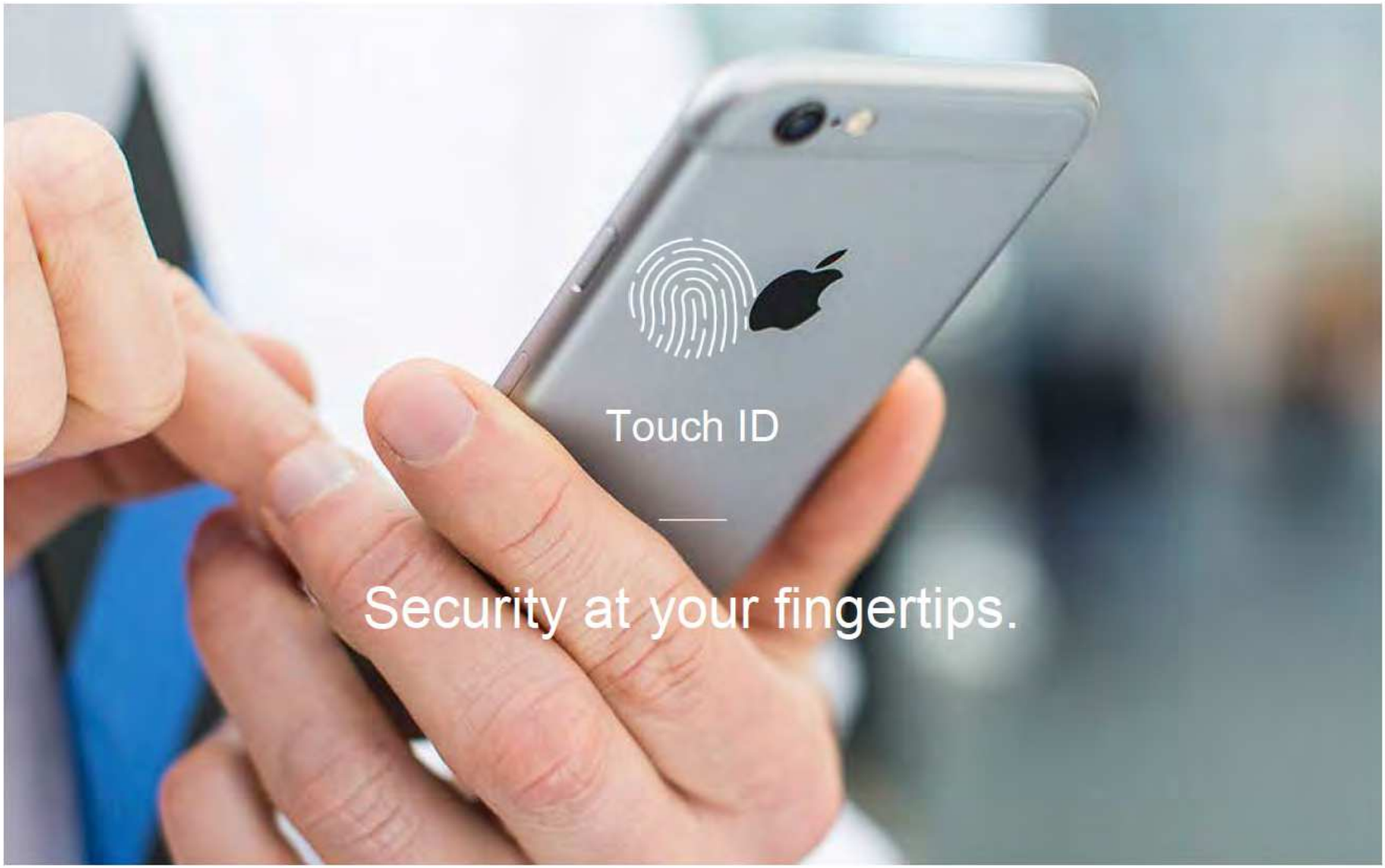
join.me
View in App Store

Put your ideas on display.

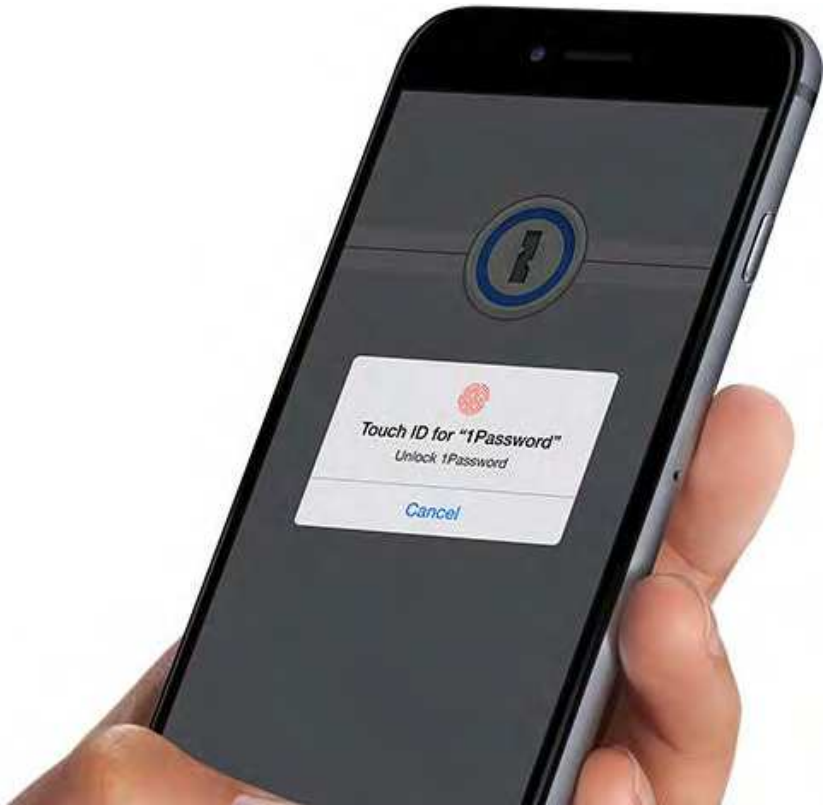
Use Paper to sketch a new product design, outline a business plan, or create diagrams — no matter where you are. And with AirPlay, you can share your ideas on the big screen to enhance collaboration and engage in more meaningful conversation.

Paper

View in App Store


Touch ID
Security at your fingertips.

Touch ID does more than just unlock your iPhone or iPad, it also lets you access the apps on your device securely. Safeguard your critical data without the hassle of managing multiple passwords — all you need is your fingerprint. A single touch ensures that even your most sensitive information stays protected.



Seamless security for all your passwords.

1Password creates a secure vault for all your passwords. So you can use Touch ID to access your websites, sensitive data, and multiple identities with one touch.

1Password
View in App Store

Get started.

There's never been a better time to reinvent your business with apps. Get started today with resources from Apple to build your own apps or check out next-generation business apps in the App Store.

Create.

Learn how to build apps that are integrated, secure, innovative, and ready to deploy. Check out the latest developer resources and get started today.

Learn more about iOS resources for developers

Explore.

Explore new ways to be more productive, reimagine workflows, and make smarter business decisions with amazing iOS apps for business.

Browse even more apps in the App Store

Shop now.

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Get help.

Locate sales and service providers near you.

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Go enterprise.

Explore how Apple and IBM can transform your business.

Learn more

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Watch
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Music
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If you ever have a question or a problem with any of your Apple products, you'll find friendly and knowledgeable help at the Genius Bar in any Apple Retail Store.
Learn more about the Genius Bar

Workshops and classes

At Apple Retail Stores, we offer free workshops that teach everything from the basics to the most advanced topics. You can also sign up for One to One training. And we even have a variety of programs tailored just for kids, such as Apple Camp.
Find an Apple Retail Store

AppleCare+

AppleCare+ gives you one-stop service and support from Apple experts, so most issues can be resolved in a single call.
Learn more about AppleCare

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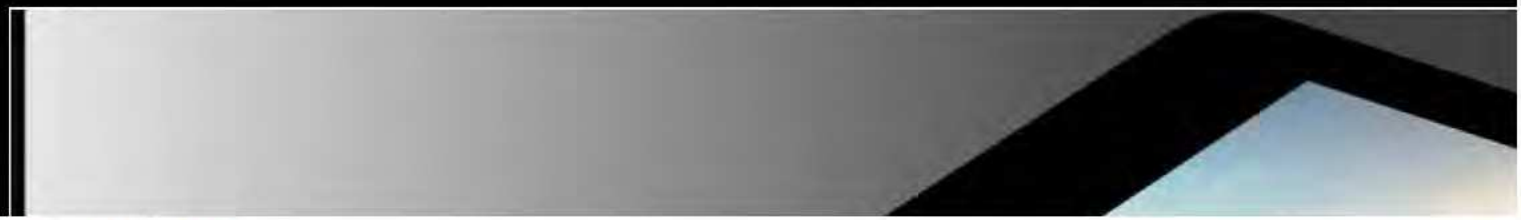

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RxD Media, LLC v. IP Application Development LLC
Opposition Nos. 91207333, 91207598

APPLICANT'S EXHIBIT 3
REDACTED IN FULL

RxD Media, LLC v. IP Application Development LLC
Opposition Nos. 91207333, 91207598

APPLICANT'S EXHIBIT 4

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

RXD MEDIA, LLC,

Plaintiff,

v.

IP APPLICATION DEVELOPMENT LLC,

Defendant.

Case No. 15-mc-80291-SK

ORDER GRANTING IN PART AND DENYING IN PART MOTION TO QUASH

Regarding Docket Nos. 1, 13, and 16

This matter comes before the Court upon consideration of Apple, Inc.'s motion to quash the subpoena issued by RxD Media, LLC ("RxD"). This motion is fully briefed and suitable for disposition without hearing pursuant to Civil Local Rule 7-1(b). Having carefully considered the parties' papers, relevant legal authority, and the record in the case, the Court hereby GRANTS IN PART and DENIES IN PART Apple's motion for the reasons set forth below.[1]

BACKGROUND

In a trademark proceeding before the Trademark Trial and Appeal Board (the "Board"), RxD opposes the registration of IP Application Development LLC's ("IPAD") IPAD mark based on RxD's purported use of the phrase "IPAD.MOBI" in connection with its mobile internet notepad. RxD moved to compel the deposition of Douglas Vetter, a vice-president in Apple's legal department, but the Board ruled that Apple was a non-party and, thus, the Board did not have jurisdiction over it. RxD then served a subpoena on Mr. Vetter. Apple now moves to quash that subpoena on the grounds that Mr. Vetter is an "apex" or high-level executive and that he does not have any substantive knowledge of facts relevant to the underlying Board proceeding.

[1] The Court GRANTS RxD's request to seal RxD's opposition brief and attached exhibits as modified by Apple's submission at Docket Nos. 22 and 23 and GRANTS Apple's request to seal. *See* Fed. R. Evid. 201. Based on the RxD's representation, the Court is not sealing the Declaration of Cecil E. Key in support of RxD's opposition. (Dkt. No. 26.)

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ANALYSIS

A. Applicable Legal Standard.

Federal Rule of Civil Procedure 45 governs discovery of nonparties by subpoena. The scope of the discovery that can be requested through a subpoena under Rule 45 is the same as the scope under Rule 26(b). Fed. R. Civ. P. 45 Advisory Comm.'s Note (1970) ("[T]he scope of discovery through a subpoena is the same as that applicable to Rule 34 and other discovery rules."); Fed. R. Civ. P. 34(a) ("A party may serve on any other party a request within the scope of Rule 26(b).").

Rule 26(b) allows a party to obtain discovery concerning any nonprivileged matter that is relevant to any party's claim or defense and that is "proportional to the needs of the case, considering the importance of the issues at stake in the action, the amount in controversy, the parties' relative access to relevant information, the parties' resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit." Fed. R. Civ. P. 26(b)(1). "A district court whose only connection with a case is supervision of discovery ancillary to an action in another district should be especially hesitant to pass judgment on what constitutes relevant evidence thereunder. Where relevance is in doubt . . . the court should be permissive." *Gonzales v. Google, Inc.*, 234 F.R.D. 674, 680-81 (N.D. Cal. 2006) (quoting *Truswal Systems Corp. v. Hydro-Air Engineering, Inc.*, 813 F.2d 1207, 1211-12 (Fed. Cir. 1987)).

A court must protect a nonparty subject to a subpoena if the subpoena "requires disclosure of privileged or other protected matter" or the subpoena "subjects a person to undue burden." Fed. R. Civ. P. 45(d)(3). A court must also limit discovery if it is unreasonably duplicative, if it can be obtained from a source that is more convenient or less burdensome, or if the burden of producing it outweighs its likely benefit. Fed. R. Civ. P. 26(b)(2)(C). Rule 45 also provides that the Court shall quash or modify a subpoena that imposes an undue burden. Fed. R. Civ. P. 45(d)(3)(A)(iii).

"On a motion to quash a subpoena, the moving party has the burden of persuasion under Rule 45(c)(3), but the party issuing the subpoena must demonstrate that the discovery sought is

relevant." *Chevron Corp. v. Donziger*, 2013 WL 4536808, *4 (N.D. Cal. Aug. 22, 2013) (internal citation omitted). "[I]f the sought after documents are not relevant nor calculated to lead to the discovery of admissible evidence, then any burden whatsoever imposed . . . would be by definition undue." *See Compaq Computer Corp. v. Packard Bell Elecs.,* 163 F.R.D. 329, 335-36 (N.D. Cal. 1995).

B. Apple's Motion to Quash.

Apple moves to quash the subpoena of Mr. Vetter on the grounds that he is a high level or "apex" executive with no knowledge of the relevant facts. "When a party seeks the deposition of a high-level executive (a so-called 'apex' deposition), courts have observed that such discovery creates a tremendous potential for abuse or harassment." *Apple Inc. v. Samsung Elecs. Co., Ltd*, 282 F.R.D. 259, 263 (N.D. Cal. 2012) (internal quotation marks and citations omitted). "In determining whether to allow an "apex" deposition, courts consider (1) whether the deponent has unique first-hand, non-repetitive knowledge of the facts at issue in the case and (2) whether the party seeking the deposition has exhausted other less intrusive discovery methods." *Id*. (quoting *In re Google Litig.*, 2011 WL 4985279, *2 (N.D. Cal. Oct. 19, 2011)).

However, "a party seeking to prevent a deposition carries a heavy burden to show why discovery should be denied." *Id*. (quoting *Celerity, Inc. v. Ultra Clean Holding, Inc.*, 2007 WL 205067, *3 (N.D. Cal. Jan. 25, 2007)). Therefore, "it is very unusual 'for a court to prohibit the taking of a deposition altogether absent extraordinary circumstances.'" *Id*. (quoting *WebSideStory, Inc. v. NetRatings, Inc.*, 2007 WL 1120567, *2 (S.D. Cal. Apr. 6, 2007)). "When a witness has personal knowledge of facts relevant to the lawsuit, even a corporate president or CEO is subject to deposition." *Id*. Moreover, "a claimed lack of knowledge, by itself it is insufficient to preclude a deposition." *Id*.

In light of the fact that the Court has granted Apple's request to keep the details regarding its organizational structure confidential, the Court will only discuss this issue in general terms. Given the size of Apple, and its multiple levels of management, the Court is not persuaded that Mr. Vetter, in his position, qualifies as an "apex" executive. Although the Court does not doubt that Mr. Vetter has demanding professional responsibilities at Apple, this is not reason enough to

limit RxD's access to potential relevant information.

Apple also argues that, as a non-party, Mr. Vetter should be protected from being deposed. The Ninth Circuit has suggested that discovery against non-parties may be "more limited to protect third parties from harassment, inconvenience, or disclosure of confidential documents." *Dart Indus. Co. v. Westwood Chem. Co.*, 649 F.2d 646, 649 (9th Cir. 1980). However, while the Board has determined that Apple is legally separate from IPAD and, thus, is a non-party, the Court notes that Apple is not an unrelated, uninterested entity.

Apple contends that although Mr. Vetter signed the Trademark License agreement at issue, he only did so at the request of Thomas LaPerle, the Director of Trademark and Copyright at Apple, and does not have any substantive knowledge of the relevant facts. However, as noted above, a claimed lack of knowledge is insufficient to preclude a deposition. RxD has already deposed Mr. LaPerle and has repeatedly requested the names of other knowledgeable individuals. Significantly, Mr. Vetter did, in fact, sign the operative agreement concerning the IPAD mark on behalf of Apple. Moreover, the Court does not find that RxD is seeking to depose Mr. Vetter to abuse or harass Apple. Apple argues that Mr. LaPerle is the only available employee with relevant information. It may be that deposing Mr. Vetter will not lead to the discovery of extensive valuable information, but the Court finds that RxD should have the opportunity to try. Nevertheless, in light of the fact that Apple is a non-party and has submitted a declaration by Mr. Vetter attesting to his limited knowledge, the Court will limit the duration of the deposition. RxD may depose Mr. Vetter for a maximum of two hours.

CONCLUSION

For the foregoing reasons, the Court GRANTS IN PART AND DENIES IN PART Apple's motion to quash. The Court DENIES the request to quash the subpoena in its entirety but is limiting the duration of the deposition to a maximum of two hours.

IT IS SO ORDERED.

Dated: January 8, 2016

SALLIE KIM
United States Magistrate Judge

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing IP APPLICATION DEVELOPMENT LLC'S RESPONSE IN OPPOSITION TO RXD MEDIA, LLC'S MOTION FOR LEAVE TO AMEND its notice of opposition was filed electronically on this 21st day of April, 2016, and a copy was electronically mailed to the following:

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